(1) Supreme Court, U.S.
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No.

In the

# UNITED STATES SUPREME COURT

COMFORT SILKIE COMPANY CORPORATION,
Petitioner,

V.

ANNETTE L. SEIFERT,
(doing business as Barefoot Dreams),
Respondent.

*On Petition For Writ of Certiorari to the Federal Circuit Court of Appeals*

## PETITION FOR WRIT OF CERTIORARI

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87pp

## QUESTIONS PRESENTED FOR REVIEW

Does a use unrelated to the patentee in public by a third party, who is not the inventor or patentee nor in privity with the inventor or patentee, invalidate the patent without a showing of the use having put the invention in possession of the public?

Does evidence offered as corroborating the public use need to be of such a nature that it provides an enabling disclosure of the claimed invention to the public?

## STATEMENT OF PARTIES

The names of all parties to the proceedings in the court whose judgment is sought to be reviewed appear in the caption in the case. There is no parent or publicly held company owning 10% or more of the Comfort Silkie's stock. The Respondent is an individual.

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## OPINIONS BELOW

1. The opinion of the Federal Circuit Court of Appeals in the matter, Comfort Silkie Corporation Company v. Annette L. Seiffert, dba Barefoot Dreams, No. 98-1476, dated July 16, 1999 is attached as Appendix 1.

2. The first opinion of the Federal District Circuit Court for the Central District of California in Comfort Silkie Corporation Company v. Annette L. Seiffert, dba Barefoot Dreams, CV96-6341 LGB(MCx), dated May 26, 1998 is attached as Appendix 2.

3. The second opinion of the Federal District Circuit Court for the Central District of California in Comfort Silkie Corporation Company v. Annette L. Seiffert, dba Barefoot Dreams, CV96-6341 LGB(MCx), dated March 31, 1998 is attached as Appendix 3.

## STATEMENT OF BASIS FOR JURISDICTION

The judgment of the Federal Circuit Court of Appeals rendered its judgment on July 16, 1999.

The Federal Circuit Court of Appeals has decided an important question of federal law in a way which conflicts with this Court's holding in *Egbert v. Lippman*, 104 U.S. 333 (1881), or has not been, but should be settled by this Court.

Jurisdiction in this Court is based on 28 USC 1254.

Notifications have been made under Rule 29.4

## CONSTITUTIONAL PROVISION AND STATUTE INVOLVED IN THE CASE.

Article I, section 8, paragraph 8, provides:

"The Congress shall have the power . . .

8. To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries; . . . "

The statute involved is 35 USC 102(b) which provides that:

> "A person shall be entitled to a patent unless . . .
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, . . . ."

## STATEMENT OF THE CASE

### A. ISSUE

This case presents the question of whether an issued U.S. Patent may be invalidated for an unrelated use of the invention in a public place made by a third party, where the invention was independently reinvented by the third party subsequent to the invention by the patentee, which use had no connection or relation to the inventor or patentee, and which use did not provide an enabling disclosure to the public, or put the invention into the possession of the public.

### B. FACTS

(1) Jeanelle and Greg Troncone ("Troncone") invented a tactile pacifier in the form of a baby blanket designed to soothe infants and toddlers by providing a smooth and silky object which could be folded and stroked. The Troncones obtained a patent on the invention, namely *"Security Blanket with Tactile Characteristics Simulative of the Amnion and Amniotic Fluid."* U.S. Patent 4,989,285

(2) The patented invention is a blanket/pacifier whose two sides, one made of satin and the other of flannel, which, when folded satin-to-satin, fluidly slides against itself while providing a soft warm tactile sensation on the opposing flannel sides when rubbed between thumb and finger. The blanket/pacifier facilitates a pacifying behavior in the infant, which behavior originates and can be observed in utero when the fetus strokes the amniotic fluid. The amniotic fluid is warm, soft, slippery and silky to the touch. The choice of materials and their construction together into a blanket is the subject matter of the patent claims.

(3) The Respondent, Annette Seifert ("Seifert") manufactures and sells crib-sized blankets (27" x 36") and other security blankets (13" x 18") which incorporates the claimed invention.

(4) Cheryl Porcaro, and her sister in law, both nonparties, had made a baby blanket, which was within the scope of at least some of the claims 1-4, 6-10 and 12. The manufacture of the blanket appears to have been an independent reinvention of a crib sized version of the claimed blanket. The evidence of used were comprised of photographs in the possession of Cheryl Porcaro, and a deposition and affidavit of Cheryl Porcaro, that she and her sister-in-law, made the blankets and that those made by the sister-in-law had been given as personal gifts to family and friends, who used by them in public places more than a year before the filing date. There is no evidence that either Porcaro made the blankets prior to the invention by the Troncones. Seifert placed one of Cheryl Porcaro's actual blankets into evidence, which, however, was not one of those used in a public place more than one year before the filing date of the '285 patent.

(5) The were six photographs of various blankets, which Cheryl Porcaro testified were taken more than a year before the filing date of the '285 patent. These blankets are shown in the photographs as being in public places. The photographs per se do not reveal the material of the two sheets that comprise the blanket, nor do they show the stitching connecting the two sheets, both of which features are elements of the patent claims. Neither normal public display nor the photographs of the same public display enables an observer to understand how the blankets differed from a common baby blanket.

(6) In a suit for patent infringement, Seifert introduced the declaration and deposition of Cheryl Porcaro. No evidence as ever offered from Susan Porcaro, who was asserted to have been the first of the two Porcaros to make the blanket, nor was there any testimony from any of the gift recipients.

(7) The parties filed Cross Motions for Summary Judgment. Partial summary judgments were granted, holding claims 1-4, 6-10 and 12 of the '285 patent invalid for public use under 35 USC 102(b), and finding infringement by Seifert's blankets of claims 5 and 11. Seifert then filed a second Motion for Summary Judgment, which was granted, the court holding claims 5 and 11 invalid as obvious over the Porcaro blanket and a stuffed hand puppet or rabbit toy sold by Fisher-Price, which puppet had a body made out of blanket material.

(8) The Federal Circuit affirmed summary invalidation under *Egbert v. Lippman,* 104 U.S. 333 (1881) as a hidden public use. No other case was cited by the Federal Circuit for its decision. Like the trial court, the Federal Circuit also ignored evidence of secondary indicia of nonobviousness.

## C. REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT

Although this case does not involve the exercise of a civil liberty or a principle of constitutional law directly affecting the civil rights of every citizen of this nation, it does involve how the federal courts administer Article I, section 8, clause 8, of the Constitution through the patent laws to promote the progress of science and useful arts by securing to inventors the exclusive right to their discoveries. In this century it is the technology and inventive energy of its people which has made America first among equal nations and upon which it will must depend in the future to keep its place. The concern of this Court with the inventors of this country will in the long run impact the future of the nation as much as any decision involving the death penalty or civil right.

This Court should not allow its precedent to be miscited by the national patent court to invalidate an

invention for some other agenda. The claimed invention can be made using simple home skills, and therefore does not inspire technological awe.[1] Thus, a reason was sought to invalidate the claims. In so doing the law regarded unrelated public use of a hidden invention was misused to invalidate the patent.

This Court must insist on the application of the rule of law to determine all issues before the national patent court. An insistence on a rule of law for the inventors of the nation is what is stake here.

## 1. A HIDDEN PUBLIC USE NOT RELATED TO THE INVENTOR OR PATENTEE DOES NOT TRIGGER A PATENT BAR

The judgment of the courts below is in error in that the holding of *Egbert v. Lippman* is limited to a hidden use of an invention in public made by or introduced in some manner by the inventor. In *Egbert* the inventor allowed or caused a third party to wear a corset in public, which corset was concealed under her clothing and in which corset the claimed rib construction was present. The public could not see or have access to corset or the claimed rib construction, because it was in an article of personal clothing and within the zone of privacy of the individual. Theoretically of course, the public could have had physical access to the corset, but only by an impermissible invasion of privacy.

Notwithstanding lack of practical opportunity for physical or visual access to the invention, *Egbert* was held to be an invalidating public, because it was an exploitation of the invention by the patentee in public for his own benefit.

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[1] The Petitioner speculates that because of this simple home technology, the trial court and panel were hostile to an invention, which they assumed must surely have been previously made by their own mothers or grandmothers.

In the present case, a use in public places was made by a third party, which use and party had no connection to the inventors or patentee. The inventors or patentee did not gain anything by virtue of the use and did not have any knowledge of it at the time it was made.

The pubic policy of section 102(b) relating to public use in support of section 8, clause 8 of the Constitution promotes science and the useful arts, but setting a one-year clock beginning with any public exploitation by the inventor of the invention or description in a printed publication. The purpose is to force the inventor to either make her claim to exclusive rights to the invention by filing for patent during the year following first exploitation or publication, or to give the invention to the public for its use.

The purpose, however, is not served where there is no exploitation by the inventor or where the public is not put into possession of the invention by virtue of the use. The inventor should be awarded with her patent rights, when she is still the first to bring the advantages of the invention to the public. A prior, unrelated, hidden public use by another by definition does not give the public the benefit of the invention nor not it grant any advantage to the inventor who does bring it to the public. For this reason, unrelated hidden public uses are not invalidating public uses under section 102(b).

## 2. USE BY THE GIFT RECIPENTS DID NOT PUT THE PUBLIC INTO POSSESSION OF THE INVENTION.

Whether there was one or many gift recipients is immaterial. The gift recipients can be assumed to have had access to the invention, namely the opportunity to determine the materials of the blanket/pacifier and the details of its construction. However, the gift recipients were personally

chosen persons who were related to either Cheryl or Susan Porcaro, or were their friends. An arbitrary member of the public who might have been interested in the details of the blanket/pacifier had no opportunity to receive one of the blankets. The blankets were not sold, offered for sale or openly made available for personal examination by any arbitrary party.

The infants and toddlers around whom the blanket was wrapped, or by whom it was clutched carried it into public places. They and their parents possessed and carried the blankets as items of personal apparel and not for the purpose of showing to the public. The public could not reasonably expect to take an item of personal apparel from the infant or toddler without an impermissible invasion of privacy. Such an intrusion would likely have invited a quick and loud verbal complaint from both the toddler and the parent. A personal item covering or held by a infant or toddler is not and cannot be reasonably understood to be an invitation to the public to take possession of it from the infant or toddler to ascertain the details of its manufacture.

*Egbert v. Lippman* does not hold to the contrary and it is an error of law to hold that such unrelated third party hidden usage makes the invention available to the public or puts it into the possession of the public. *Egbert* found public use despite the fact that there too the invention was kept from the public examination by expectations of privacy regarding possession of the invention when used in public. However, *Egbert* differs significantly from the present case in that here the inventor or patentee had nothing whatsoever to do with the use on which invalidation is based.

## 3. THE USAGE MADE BY UNRELATED THIRD PARTIES IN THIS CASE WAS NOT AN ENABLING DISCLOSURE TO THE PUBLIC.

A third party unrelated use could still invalidate a patent, but only if that use put the public into possession of the invention, i.e. gave a reasonable opportunity to an arbitrary member of the interested public to obtain an enabling disclosure of the invention, namely to see how it was made and used.

Absent clear and convincing evidence that the unrelated third party use did or was capable of putting the public into possession of the invention, the judgment of the Federal Circuit is contrary to this Court's opinion in *Egbert*. Only the testimony of a third party infringer, Cheryl Porcaro, and her photographs, which did not show the limitations of the patent claims, i.e. the different tactile characteristic of the two opposing sides of the blanket and how those sides were joined, were submitted as "corroborated, clear and convincing evidence" that the public was put into possession of the invention. It cannot be determined by looking at the photographs that the blankets were not just common blankets having nothing to do with the claimed features.

The Federal Circuit found the photographs to be corroborated by certain dates on the back of the photograph and set by the user into the camera image. While these dates might have corroborated the date the photographs was taken or processed, it was irrelevant to the subject matter shown in the photograph. There is nothing to guarantee that the photographs were nothing more than photos of common blankets, other than the uncorroborated testimony of Cheryl Porcaro on this issue. Cheryl Porcaro is also a current commercial infringer to whose direct and personal interest is served by the invalidation of the patent.

The invention as claimed relates to a certain choice of materials and stitching or construction of those materials to create a baby blanket that serves as a tactile pacifier, simulating the tactile feel of the amniotic fluid and thereby inducing a stroking behavior by the infant. Such a usage cannot be shown in a still photograph. Neither the choice of materials nor the stitching is ascertainable without actually touching the blanket and examining it at close range. The hidden stitching of a blanket or any article of clothing cannot be determined simply by viewing it on the wearer, even from close range, particularly where the hidden side is as important to the invention as the exposed side.

In its preferred embodiment the claimed blanket is in fact too small to serve as a blanket, but is usable only as a tactile pacifier. All of the Porcaro blankets were crib blankets, which were large enough to function as coverings. There is no evidence that these blankets had any particular tactile characteristic or were utilized by any of the gift recipients because of their tactile characteristics. No testimony was given by any gift recipient concerning the blankets given as gifts.

Instead, the finding was made by the Federal Circuit that articles covered by the claims were used in public "without an expectation of privacy or confidentiality on the part of the user". The entire decision of the Federal Circuit turns on an assumed fact, which was entirely concocted in the imagination of the Circuit Court. If there were "an expectation of privacy" then presumably the Circuit Court would have found not public possession and hence no public use. If this were not the case then *Egbert* was clearly misapplied under the Circuit Court's own precedent. Either way there is an error of law.

The "found" lack of expectation of privacy is an unsupported factual assertion relating to the expectation of

the gift recipient, which the Circuit Court has fabricated from whole cloth. There was no testimony of any sort relating to the expectations or any other subjective state of mind in the situation before the court of the gift recipients or for that matter the public. There was no evidence of any kind from any gift recipient's expectation.

The issue is neither the expectation of privacy of either the gift recipient or the public. The question does not turn on a subjective state of mind. Instead the issue is under the circumstances whether the public had reasonable access to the invention to enable itself to make and use the invention. Just as in the case where a thesis is deposited with a university library, it is not published until it is cataloged in the library's card index notwithstanding the fact that perhaps in might be theoretically accessible by a special request through the library acquisitions department. Until cataloged it was not made "sufficiently accessible" to the public who wished to look for it. It is not a publication because the student's three thesis advisors were given copies to read for the defense of the thesis. *See, In re Cronyn,* 890 F2d 1158, 13 USPQ2d 1070 (CAFC 1989); *In re Hall, 781 F2d 897, 228 USPQ 453 (CAFC 1986)* Here too, a blanket wrapped around a sleeping toddler does not become sufficiently accessible to the public. The gift recipients are like the thesis advisors and their possession does not make it publicly available. It is not put on display and is not made available for arbitrary examination. A member of the public could certainly ask the mother of the infant, if the blanket could be surrendered for examination, just as a library user could ask the library acquisitions department if a thesis were in its acquired uncataloged works. However, in both situations, the blanket or thesis would not have been made sufficiently available to the public.

Even if such an expectation existed, the expectation of the user does not determine whether in fact or not the use

made in public was enabling, made the invention available to the public, or put it into the possession of the public. The question is whether an arbitrary member of the interested public could in fact obtain access to the invention if desired. Access to the invention by any interested member of the public may be not be reasonably expected by the public, because of societal norms against nonpermitted public touching or trespass onto personal possessions held next to the skin or in the possession of infants or small children. The possessor's subjective expectation of confidentiality or privacy is not determinative. In a normal view of the blanket there is no express or implicit invitation to take it from its possessor. The "access" required is that access which is necessary to enable the interested public to make the invention and use the invention. Normal public view alone in this case did not enable the public to make the invention and there was no finding that it did. Physical examination of the blanket is necessary to see that it is more than just a common blanket.

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## 4. THE FEDERAL CIRCUIT COURT OF APPEALS DOES NOT APPLY A RULE OF LAW TO THE PRESENT CASE.

While the Federal Circuit states in passing without citation that it does not restate settled law, it has ignored its own contrary settled law in this case, which was argued on appeal. *Woodland Trust v. Flowertree Nursery Inc.*, 148 F3d 1368, 47 USPQ2d 1363 (Fed. Cir. 1998) held that when an asserted prior use is not that of the inventors, Section 102(b) is not a bar when that prior use or knowledge is not available to the public. *W.L. Gore & Assocs.. Inc. v. Garlock Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 310 (Fed. Cir. 1983) (third party secret commercial activity, more than one year before the patent application of another, is not a §102(b) bar); Irving Kayton, *Patent Practice* §4.41 ("Where the commercially advantageous, secret use is by a third party and even though that use is for a period more than one year before the

applicant's filing date, it cannot constitute a statutory time bar under §102(b)."). The public policy of applying 102(b) against an inventor's use is driven by different considerations than when the use is by a third party.[2]

As the Federal Circuit Court also held in *Woodland Trust* in order to invalidate a patent based on prior use or knowledge, *that use or knowledge must have been available to the public. Carella v. Starlight Archery,* 804 F.2d 135, 139, 231 USPQ 644, 646 (Fed. Cir. 1986) (the §102(a) language "known or used by others in this country" means knowledge or use which is accessible to the public); 35 U.S.C. §102(a) reviser's note (1952) (noting that "known" has been held to mean "publicly known"); P.J. Federico, *Commentary on the New Patent Act* (1954) reprinted in 75 J. PAT. TRADEMARK OFF. SOC'Y 161, 178 (1993) ("interpretation [of §102(a)] by the courts excludes various kinds of private knowledge not known to the public"; these "narrowing interpretations are not changed"). *See also Coffin v. Ogden,* 85 U.S. (18 Wall.) 120, 124-25 (1873) (accessible hence anticipating prior use); *Gayler v. Wilder,* 51 U.S. (10

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[2] The public policies to be served by the public use bar are: (1) discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available; (2) favoring the prompt and widespread disclosure of inventions; (3) allowing the inventor a reasonable amount of time following sales activity to determine the potential economic value of the patent; and (4) prohibiting the inventor from commercially exploiting the invention for a period greater than the statutorily prescribed time. *Lough v. Brunswick Corp.,* 86 F3d 1113, 39 USPQ2d 1100 (CA FC 1996). Only the first two grounds apply to an unrelated use and in each case the public policy is not served if the use is hidden or the public is not put into possession of the invention by virtue of the use.

How.) 477, 497-98 (1850) (nonaccessible hence nonanticipating prior use).

## CONCLUSION

The judgment of the Federal Circuit is contrary to *Egbert v. Lippman* and its own holdings in *Woodland Trust v. Flowertree Nursery Inc.* and *W.L. Gore & Assocs., Inc. v. Garlock, Inc.* Clarification by this Court of the scope its holding in *Egbert v. Lippman* as it applies to third party unrelated hidden public uses is needed. The national patent court is misusing this Court's ruling in *Egbert* in violation of section 8, clause 8, of the Constitution. Such an action is an unlawful taking of private property by the courts just as surely as if title to real estate were at issue.

It has been perhaps more than one hundred years since this Court has ruled on the public use bar of hidden, uses under the patent laws. It may have never ruled on hidden, nonenabling and unrelated uses. It is due time to clarify the scope of that 119 year ruling.

The Court should answer the questions presented for review as follows:

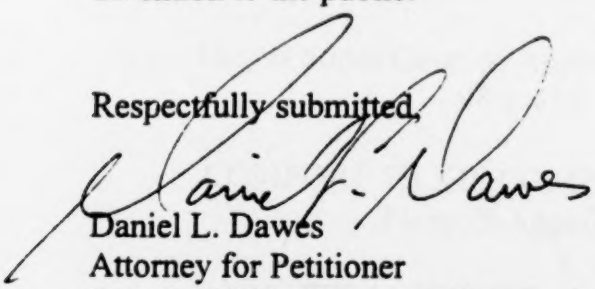
1. The lower courts have not consistently applied a rule of law to decide cases before it in that the lower courts in summary proceedings (i) misconstrued a decision of this Court; (ii) ignored plausible evidence supporting the patentee; (iii) ignored its own contrary decisions; and (iv) created findings of fact not in the record.

2. An a use by a third party in public which use is unrelated to the patentee, and which third party is not the inventor or patentee nor in privity with the inventor or patentee, does not invalidate the patent without a showing by

clear and convincing evidence that the use put the invention into possession of the public.

3. Evidence offered as corroborating a public use needs to be of such a nature that the corroborating evidence itself provides an enabling disclosure of the claimed invention to the public.

Respectfully submitted,



Daniel L. Dawes
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Comfort Silkie Company Corporation

## APPENDIX 1 - MEMORANDUM OF THE FEDERAL CIRCUIT COURT OF APPEALS DATED JULY 16, 1999.

NOTE: Pursuant to Fed. Cir.R. 47.6, this disposition is not citable as precedent. It is a public record. The disposition will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit
98-1 476

COMFORT SILKIE COMPANY CORPORATION,
Plaintiff-Appellant,
v.
ANNETTE L. SEIFERT (doing business as Barefoot Dreams),
Defendant-Appellee.

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DECIDED: July 16, 1999

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Before MICHEL, LOURIE, and RADER, Circuit Judges.

MICHEL, Circuit Judge.

This is an appeal from the May 29, 1998 decision of the United States District Court for the Central District of California holding invalid on summary judgment all claims of United States Patent No. 4,989,285 ("the '285 patents). See Comfort Silkie Co. Corn, v. Seifert, No. CV 96-6341 (C.D. Ca. May 29, 1998). Plaintiff-Appellant Comfort Silkie Company Corporation ("Comfort Silkier) is the owner of the '285 patent, a patent directed to a baby blanket and titled Security Blanket with Tactile Characteristics Simulative of the Amnion and Amniotic Fluid." Defendant-Appellee Annette Seifert ("Seifert") manufactures and sells crib-sized blankets (27" x 36n) designated by the Trademark DREAM WITI I ME and other security blankets (13" x 18") designated by the Trademark BLANKIE-TO-GO. On

September 10, 1996, Comfort Silkie filed its Complaint against Seifert alleging infringement of the '285 patent. On April 30, 1997, Seifert filed her Answer and Counterclaims, seeking (1) declaratory judgments of invalidity and noninfringement and (2) injunctive and monetary relief for false advertising pursuant to 15 U.S.C. §1125(a). The second of these claims was dismissed with prejudice by stipulation of the parties on February 12, 1998.

Meanwhile, on November 7, 1997, Seifert filed a Motion for Summary Judgment of Noninfringement on the basis that Seifert's blankets do not infringe the '285 patent. On December 1, 1997, Comfort Silkie filed its Opposition and Cross-Motion for Summary Judgment. Partial summary judgments were granted, holding claims 14, 610 and 12 of the '285 patent invalid for public use, and finding infringement by Seifert's blankets of claims 5 and 11 of the '285 patent. Seifert then filed a second Motion for Summary Judgment, which was granted, the court holding invalid as obvious claims 5 and 11 of the '285 patent. Comfort Silkie timely appeals from both orders and the judgment of invalidity as to all claims. Because every claim in the '285 patent was either not novel, due to having been publicly used more than one year before the patent application was filed, or obvious in light of the prior art, we affirm.[1]

Because the parties are familiar with the facts of the case, we will not recount them here. Nor need we restate settled law on summary judgment, public use or obviousness.

## DISCUSSION

The patented invention was, essentially, a baby blanket whose two sides, one made of satin and the other of flannel, slide when rubbed between thumb and finger. Cheryl Porcaro, a non-party, had made a baby blanket whose two sides, respectively, made of satin and flannel, slide when rubbed between thumb and finger. Evidence was introduced

[1] We do not reach the district court's infringement decision.

in the form of photographs, depositions and affidavits that Mrs. Porcaro and her sister have been making these blankets for more than a year before the filing date of the application that issued as the '285 patent and have been using them in public. Comfort Silkie argues that there is insufficient evidence to clearly and convincingly prove that the blankets were used publicly more than a year before the filing date, and any use before the critical date of the baby blankets was not Public use," as required by 35 U.S.C. §102(b).

Seifert placed one of Mrs. Porcaro's actual blankets into evidence, and six photographs of various blankets, which Mrs. Porcaro testified were taken more than a year before the '285 patent was applied for. Comfort Silkie's attorney took Mrs. Porcaro's deposition and questioned her about the precise dates. The dates on which the photographs were actually taken are verified a number of different ways. Several of the pictures have the photography lab processing date on them; some are dated by the camera itself; and some have handwritten dates on them. Furthermore, Mrs. Porcaro's recollection of when the photographs were taken was assisted by a variety of factors: their particular location in her photograph album; the activity within them, e.g., a wedding, or Fourth of July celebration; the age of the children clutching the blankets; and finally, the state of her pregnancy and the birth of her daughter. It is undisputed that these blankets were taken into public places (as can be seen from the photographs) like airports, public parks, and restaurants with no expectation of privacy or confidentiality.

Upon looking at the whole record, we agree that there is clear and convincing evidence that, as a matter of law, the patented blanket was used publicly more than a year before the patent application was filed. Furthermore, the use was sufficiently public to render invalid Comfort Silkie's patent under 35 U.S.C. §102(b). Although Comfort Silkie argues that a baby blanket cannot be considered to have been in public use because it was within the baby's realm of privacy and could not be touched by strangers, we note that if the

Supreme Court has held that a woman wearing a corset stay, under her clothes, is a public use, then a fortiori, a baby playing with a blanket in public locations observable by others is a public use. See Egbert v; Lippman, 104 U.S. 333 (1881).

The baby blankets made by Mrs. Porcaro, however, were all undisputedly larger than 29 inches by 36 inches and therefore claims 5 and 11 of the '285 patent which contain a size limitation of Dimensions of 14 inches by 18 inches or less. cannot be invalid for public use. However, Fisher-Price has tirade, since 1979, a cloth rabbit toy under the mark SECURITY BUNNY, in which the body of the rabbit toy is made of a single ply of blanket-type material with a satin binding. When laid as flatly as possible, the toy, although not itself rectangular, could be circumscribed within a rectangular envelope of the order of 14 inches by 18 inches.' The Security Bunny is clearly analogous art, and when combined with the Porcaro blanket, we agree that the size limitation in claims 5 and 11 of the '285 patent would have been a maker of routine variation and therefore the blankets of these two claims were obvious under 35 U.S.C. §103.

We therefore agree with the district court that as a matter of law all claims in the '285 patent were proven invalid.

**APPENDIX 2 – MEMORANDUM OF THE FEDERAL DISTRICT CIRCUIT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA DATED MAY 26, 1998.**

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| COMFORT SILKIE CO. CORP.<br>Plaintiff,<br><br>v.<br><br>ANNETTE SEIFERT dba BAREFOOT DREAMS,<br>Defendant. | CV 96-6341 LGB<br><br>JUDGMENT |
| ANNETTE SEIFERT dba BAREFOOT DREAMS,<br>Counterclaimant,<br><br>v.<br>COMFORT SILKIE CO. CORP.<br>Counterdefendant. | |

The Court hereby ORDERS, ADJUDGES, and DECREES that judgment be and hereby is entered in favor of Defendant Annette Seifert dba Barefoot Dreams, and against Plaintiff, Comfort Silkie Co. Corp., as to Plaintiff' claim for infringement of U.S. Patent 4,989,285. Plaintiff shall take nothing by its Complaint.

The Court hereby ORDERS, ADJUDGES, and DECREES that judgment be and hereby is entered in favor of Defendant Annette Seifert dba Barefoot Dreams, and against Plaintiff, Comfort Silkie Co. Corp., as to Counterclaimant's claim for declaratory judgment of invalidity. U.S. Patent 4,989,285 is hereby DECLARED INVALID.

SO ORDERED.

Dated: May 27, 1998

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| COMFORT SILKIE CO. CORP.<br>Plaintiff,<br><br>v.<br><br>ANNETTE SEIFERT dba BAREFOOT DREAMS,<br>Defendant. | CV 96-6341 LGB<br><br>ORDER GRANTING DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF INVALIDITY (PLAINTIFF'S MOTION MOOT) |
| ANNETTE SEIFERT dba BAREFOOT DREAMS,<br>Counterclaimant,<br><br>v.<br>COMFORT SILKIE CO. CORP.<br>Counterdefendant. | |

## I. INTRODUCTION AND BACKGROUND

The motion of defendant Annette Seifert dba Barefoot Dreams ("Seifert") for summary judgment of the invalidity of Claims 5 and 11 of the '285 patent on the basis of obviousness came on regularly for hearing on May 18, 1998. Plaintiff' motion seeking enforcement of the patent was also scheduled for hearing May 18, 1998. Having carefully considered the papers submitted and oral argument of counsel, the Court hereby GRANTS defendant's motion. As the patent is therefore invalid, plaintiff's motion in rendered MOOT.

This case arises from a dispute between two makers of blanket. for infants, one of whom holds a patent. By Order entered April 3, 1998, this Court invalidated all claims of plaintiff Comfort Silkie Corporation's ("Comfort Silkie") U.S. Patent 4,989,285 ("the '285 patent"), with the exception of dependent Claims 5 and 11. That Order is incorporated herein by reference in its entirety.

The procedural and factual background of this case is set out in detail in this Court's April 3, 1998 Order, and will therefore not be restated.

On April 20, 1998, Seifert filed the instant motion for summary judgment of invalidity. On May 4, 1998, Comfort Silkie filed its opposition. No Reply was filed. In conformity with this Court's Minute Order of May 6, 1998, Seifert filed a Declaration of Kathleen Kennedy on May 12, 1998.

On April 27, 1998, Comfort Silkie filed a motion for summary judgment of damages and injunction. On May 4, 1998, Seifert filed her Opposition. Plaintiff's Reply was filed May 11, 1998.

II. THE PATENT IN SUIT

Plaintiff has a patent on its baby blanket., U.S. Patent 4,989,285 (the "'285 patent") . The '285 patent contains 12 claims, six of which are independent. All independent claims of the patent were invalidated by this Court's April 3, 1998 Order, as well as all dependent claims with the exception of dependent Claims 5 and 11, which appear in bold face below. The invalidated claims on which they depend are also set out below. The relevant claim language is as follow.:

1. An apparatus for providing pacification to an infant by tactile simulation of an amniotic environment comprising: a first textile sheet having a first type of tactile characteristic and having a peripheral boundary; a second textile sheet

having a second type of tactile characteristic and having a peripheral boundary, said first and second sheets selectively coupled together to allow slipping of said first and second sheets with respect to each other when manually manipulated by said infant, so that said apparatus is tactilely simulative of said amniotic environment, wherein said first and second sheets, have a common peripheral boundary and are connected together only at their common peripheral boundaries. ('285 patent, Col. 4, 11.28-42.)

5. The apparatus of claim 1 used in combination with infant furniture wherein said first and second sheets are generally rectangular with dimensions or 14 inches by 18 inches or less to avoid entanglement with said infant and infant Furniture. ('285 patent, Co. 4, 11. 60-64.)

9. An apparatus for providing pacification by tactile simulation of an amniotic environment comprising: a first textile sheet having a first type of tactile characteristic and having a peripheral boundary; a second textile sheet having a second type of tactile characteristic and having a peripheral boundary, said first and second sheets selectively coupled together to allow slipping of said first and second sheets with respect to each other when manually manipulated by said infant, so that said apparatus is tactilely simulative of said amniotic environment, wherein said second sheet is satin and wherein said first sheet is flannel, and further comprising a common peripheral boundary of said first and second sheets, and a textile boundary layer substantially circumscribing said common peripheral edges of said first and second sheets, said boundary layer having a predetermined tactile characteristic. ('285 patent, Col. 6, ll. 3-21.) 10. The apparatus of claim 9 wherein said first tactile characteristic is distinct from said second tactile characteristic, but wherein sliding friction between said first and second sheets i. low on account of said corresponding first and second tactile characteristics of said sheets. ('285 patent, Col. 6, 11. 22-26.)

11. The apparatus of claim 10 wherein said first and second sheets are generally rectangular with dimensions of 14 inches by 18 inches or less. ('285 patent, Col. 6, 11. 27-29.)

III. SUMMARY JUDGMENT OF INVALIDITY

Defendant Seifert moves for summary judgment that Claims 5 and 11 of the '285 patent are invalid on the basis of obviousness, pursuant to 35 U.S.C. §103. In this Court's April 3, 1998 Order, the Court found infringement of Claims 5 and 11; however, the Court stated, "This result does not preclude the defendants from bringing forward other invalidity defenses as to Claims 5 and 11, such a. obviousness under 35 U.S.C. §103 or invention by another under 35 U.S.C. §102 (g), which may then invalidate those claims and moot any infringement." (Order 41:19-23.)[1] On this basis, the Court will determine defendant's invalidity motion before turning to plaintiff's motion for relief based on a finding of infringement.

[1] Thus Plaintiff's repeated statements that "Defendant was adjudged to have infringed Claims 5 and 11. (Pl.'s Opp. 1:20) and "Claims 5 and 11 have been found infringed" (Pl.'s Opp. 23:9) are at best incomplete. Currently before the Court is precisely the sort of motion the Court anticipated might moot the conditional finding of infringement. Such a motion is not defeated on the basis that infringement has already been found.

A. Applicable Legal Standards

1. Summary Judgment

a. In General

Summary judgment shall be granted if the evidence supporting the motion for summary judgment shows that "there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). A party moving for summary judgment may carry its initial burden by pointing out to the district court that there is an absence of a genuine issue of material fact. Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986). "The plain language of Rule 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." Celotex, 477 U.S. at 322. If the non-moving party bears the burden of proof at trial, the moving party may carry its burden by showing an absence of evidence to support the non-moving party's case. Celotex, 477 U.S. at 323.

To avoid summary judgment, the non-movant must set forth specific facts showing that there remains a genuine issue of material-fact for trial. Celotex, 477 U.S. at 324. The non-movant "may not rest upon the mere allegations or denials of the adverse party's pleading." A factual dispute is "genuine" if a reasonable jury could return a verdict for the nonmoving party. Anderson v. Liberty Lobby. Inc., 477 U.S. 242, 248 (1986). The evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in the non-movant's favor. Id. at 255. If the nonmoving party's evidence is merely colorable or is not significantly probative, then summary judgment may be granted. Id. at 249-50.

District courts "possess the power to enter summary judgment sua sponte, so long a. the losing party was on notice that she had to come forward with all of her evidence." Celotex, 477 U.S. at 326. Where one party moves for summary judgment and at the hearing the court determines there is no genuine issue of material fact and the opposing party is entitled to judgment as a matter of law, sua sponte judgment in favor of the opposing party is appropriate so long as the losing party "had a full and fair opportunity to ventilate the issues involved in the motion." Cool Fuel Inc. v. Connett, 685 F.2d 309, 311-12 (9th Cir. 1982). b. In the Patent Context

When supported by the facts and law, summary judgment is appropriate in patent cases. See. e.g.. Barmag Marmer Maschinenfabrik AG v. Murata Mach.. Ltd., 731 F.2d 831 (Fed. Cir. 1984).

That is, non-anticipatory prior art, which therefore doe. not invalidate a patent under §102, may nevertheless be sufficiently close to the patented device as to render the patent claims obvious' and therefore invalid, under this section. Moreover' while §102 requires anticipation in a single item of prior art, obviousness may rest on the prior art "as a whole," including multiple prior art references. Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530, 1536 (Fed. Cir. 1983).

Whether a reference or a combination of references renders a Claimed invention obvious under §103 is a question of law. In re GPAC, 57 F.3d 1573, 1577 (Fed.Cir. 1995). The factual findings upon which a finding of obviousness rests are (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention; (3) the level of ordinary skill in the art at the time of the invention; and (4) objective evidence of obviousness or nonobviousness. Id. The obviousness determination is made as if a person of

ordinary skill in the art had all the relevant prior art before him. In re Winslow, 365 F.2d 1017, 1020 (C.C.PA. 1966).

B. Discussion

The facts will be presented in the context of the factual findings upon which the obviousness determination must be made. Facts presented below are relevant and undisputed.

1. Scope and Content of Prior Art

The scope of prior art should primarily encompass references reasonably pertinent to the inventor's field of endeavor.

Heidelberger Druckmaschinen AG v. Hndscho Commercial Products Inc. 21 F 3d 1068, 1071 (Fed. Cir. 1994). In this case, the inventor's "field of endeavor" is the production of security blankets for infants and toddlers.

Prior art includes subject matter presented as part of a §102 defense, even if it is not fully anticipatory. Lamb-Weston v. McCain Foods, Ltd., 78 F.3d 540, 545 (Fed.Cir. 1996). In this Court's Order granting Seifert's prior motion for summary judgment of invalidity' all claims other than Claims 5 and 11 of the `285 patent were invalidated pursuant to 35 U.S.C. §102(b) (public use). (order 31:6-3S:2~) The invalidating public use involved blankets made by Cheryl Porcaro, which therefore constitute "prior art." (Order 31:16-35 2.)

The "content" of the Porcaro blanket prior art includes all elements of the claims of the '285 patent with the exception of Claims 5 and 11's maximum size limitation of 14" x 18".

(Order 35 3-4.)[2] All of Porcaro's blankets measured 29" x 36" or

larger. (Order 35:6-8.) Indeed, it was the absence of any smaller size blankets which precluded this Court's invalidating Claims 5 and 11 on the basis of the public use of the Porcaro blankets.

Seifert has presented admissible evidence of small blankets with a bunny head made by Fisher-Price, the subject of a

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[2] In Comfort Silkie's Opposition to Seifert's Motion, Comfort Silkie make. what is in effect a new claim construction argument as to Claim 5; namely, that Claim 5 not only limits Claim 1 to a blanket no larger than 14" x 18" (April 3, 1998 Order 23:7-8), but that Claim 5 requires as a separate element deliberate "avoid[ance of] entanglement with the infant and infant furniture." (Pl.'s Opp. 7:26-27.) Plaintiff did not present this argument in the earlier motion for summary judgment, which explicitly addressed claim construction, nor did plaintiff object to the court'. construction of Claim 5 in the April 3, 1998 order, in which the Court explicitly construed Claim 5 as adding nothing to Claim 1 but a size limitation. Nor did Comfort Silkie present, or the Court require, evidence of the use of the allegedly infringing smaller blankets "in combination with infant furniture," an element Comfort Silkie now argues is an essential part of Claim 5.

The teaching of Claim 5 is that a smaller blanket will avoid entanglement with the infant and the furniture, should the blanket be so used. The language of Claim 5 which refers to the infant and infant furniture addresses the use of the invention, not an element of the invention. The Court therefore does not depart from the construction of Claim 5 adopted in the April 3, 1998 Order.

U.S. design patent D-261,405, which issued October 20, 1981. (Mot., Exh. 1.)[3] A security-blanket type product made by Fisher-Price for babies or toddlers is within the same "field of endeavor" as the inventor of the '285 patent, and thus the Fisher-Price item falls within the scope of the prior art. The Fisher-Price product measures approximately 10" by 15". (Exh. 1.) This item was marketed as early as 1979. (Seifert Decl. ¶3.)[4] The sample presented by Seifert we. purchased by its owner in 1985.

(Kennedy Decl. ¶2-3.)[5] The "content" of the prior art therefore includes an item of a size smaller than 14" x 18".

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[3] Comfort Silkie objects to Exhibits 1, 2, and 3. Exhibit 1 (the Fisher Price item) is offered as prior art on the basis only of its size and date; therefore, Comfort Silkie's objections as to whether Exhibit 1 embodies other elements of the '285 patent are irrelevant. By the same token, plaintiff's arguments about the many elements of the '285 patent not found in the Fisher Price item are also irrelevant. (See, e.g., Pl.'s Opp. 4:215:15; 7:10-13; .) The size of Exhibit 1 is approximately 10" x 15n. On the-basis of the Kennedy Decl., plaintiff's objections to Exhibit 1 are OVERRULED. The Court has not relied on Exhibits 2 and 3, and the objections to those Exhibits will therefore not be determined.

[4] Comfort Silkie objects to Seifert Decl. ¶2. The Court has not relied on ¶2, and the objection therefore will not be determined.

[5] On May 13, 1998, Comfort Silkie filed Objections to the Kennedy Declaration. As the Court has relied on the Kennedy Declaration only to establish the date at which Exhibit 1 was made (1985 or earlier), Comfort Silkie's

On this basis, the Porcaro blanket teaches the use of the satin-and-flannel combination, with "slipping," for making a security blanket for infants, toddlers, and children. The Fisher-Price item teaches the making of a security item for a small infant or child in a size approximating 14" x 18".

2. Differences Between Prior Art and Claimed Invention

In this case, the principal difference between the Porcaro prior art and the invention claimed by Claims 5 and 11 is that the claimed invention is a smaller blanket.

3. Reason, Suggestion, or Motivation to Combine

In Pro-Mold & Tool Co. v. Great Lakes Plastics, 75 F.3d 1568 (Fed.Cir. 1996), the Federal Circuit reviewed a district court's determination of obviousness in a care in which two items of prior art "together contain all the elements of the invention," where the first "contains all the elements of the invention except for its size," and the second "provided this missing element." Pro-Mold, 75 F.3d at 1572. The patented invention in Pro-Mold was a holder for athletic cards just slightly larger than the cards themselves. The Federal Circuit held, "If the invention is different from what is disclosed in one reference, but the difference. are such that combination with another reference-would lead to what is claimed, the obviousness question then requires inquiry into whether there is reason, suggestion, r motivation to make that combination." Pro-Mold, 75 F.3d at 1573.

Therefore, in order to invalidate a patented invention which combines prior art components to achieve a new item, the prior art must provide a suggestion or motivation to make

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objections which go to matters not considered by this Court are MOOT.

such a combination. Heidelberger, 21 F.3d at 1072. However, under In re Nilssen, 851 F.2d 1401, 1403 (Fed. Cir. 1988), prior art references "need not explicitly suggest combining teachings."

In this case, as in Pro-Mold, the claimed invention can be described as a combination of two prior art references, differing from the first reference only by being made in the size of the second reference. Because the smaller-sized Fisher-Price item was used by infants for security, the Fisher-Price item can properly be regarded as providing "reason, suggestion, or motivation" to make a smaller Porcaro-style blanket, even one which would not be large enough to wrap or cover a baby. Pro-Mold, 75 F.3d at 1573.

4. Obviousness to One or Ordinary Skill in the Art

The obviousness determination is made as if a person of ordinary Skill in the art had all the relevant prior art before him. In re Winslow, 365 F.2d 1017, 1020 (C.C.PA. 1966). Comfort Silkie makes several arguments in support of its contention that making a Porcaro blanket in the 14" x 18" size is not obvious to one of ordinary skill in the art.

Comfort Silkie's strongest argument in favor of the nonobviousness of the small blanket claimed in dependent Claims 5 and 11 is that without knowledge of the "pacification" (or security) purpose of a blanket like the Porcaro blanket, that making a "blanket too small to function as a blanket" (that is, to cover and provide warmth) (Meisenholder Decl. 18) would be nonobvious. Even apart from other evidence of obviousness set out at 5. below, and the use of the smaller Fisher-Price item as a security item for babies, plaintiff has presented no evidence that a blanket 14" x 18" is "too small to function as a blanket" for one group of users of the small blankets, premature infants "in neonatal intensive care units" (J. Troncone Dec. 1, 1997 Decl. ¶14).

Comfort Silkie therefore argues that to one who does not share the inventor's purpose of making a pacification or security device, combining the blanket-construction elements from the Porcaro blanket with the size element from the Fisher-Price item would be nonobvious. Seifert identifies herself as one of ordinary skill in "the design and manufacture of children's blankets." (Seifert Decl. ¶5, attached to Seifert Mot.) She has also testified that making the Porcaro blanket in a size defined by the Fisher-Price product is "obvious." (Seifert Decl. ¶5.) Comfort Silkie argue., on the basis of Seifert's earlier testimony that she believed the smaller blanket was used as a burping cloth (Seifert Depo. 90:17-22, 91:22-92:13), that it was not obvious to her to use the smaller blanket as a pacification device. (Pl.'s Opp. 4:11-18.)

This misconstrues the standard. Under In re Nilssen, 851 F.2d 1401 (Fed. Cir. 1988), the determination of obviousness attributes to the person of ordinary skill in the art "knowledge of all prior art in the field of the inventor's endeavor and of prior art solutions for a common problem even if outside that field" (emphasis added). Nilssen, 851 F.2d at l4O3. As set out above at 9:1-3, in this case, the inventor's "field of endeavor" is the production of security blankets for infants and toddlers. Therefore, the obviousness determination in this case is to be made from the point of view of a person of ordinary Skill in the art of making security blankets for infants and toddlers, who is aware of prior art solutions for a common problem. The Fisher-Price item itself, by its small-size, embodies a "prior art solution for a common problem," namely, the need for a small-size security item for an infant or toddler.[6]

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[6] It should also be noted that Comfort Silkie has presented no evidence that a blanket 14" x 18" is "too small to function as a blanket. for at least one group of users of the small blankets, premature infant. "in neonatal intensive care units

Moreover, one of ordinary skill in the art solves problems in an ordinary manner, without either patient, systematic research or extraordinary insight. Williams Service Grout Inc. v. O.B. Cannon & Son. Inc., 33 U.S.P.Q.2d 1705, 1725 (E.D.Pa. 1994). Comfort Silkie has presented no evidence that it requires patient, systematic research nor extraordinary insight to solve the other problem the small size blankets are meant to solve, "avoid[ing] entanglement [of the blanket] with said infant and infant furniture" (Claim 5).

Making a security item in a size approximating 14" x 18", either as an appropriate size for an infant security item or to avoid entanglement with the infant and infant furniture, is therefore within the knowledge of the person of ordinary skill in the art. Thus, to the extent that making the blanket in the smaller size served the inventor's purpose of providing a suitable security item, that solution to achieve that purpose is part of the prior art, and does not defeat obviousness.

Comfort Silkie also argues that Seifert is not one of ordinary skill in the art, as Seifert is "not a designer of infant products and had no experience in the field of infant products." (Pl.'s Opp. 9:23-25.) If anything, this bolsters Seifert's obviousness argument, for if the invention is obvious even to one with no skill in the art, surely it would be obvious to one of ordinary skill. Similarly, the fact that Seifert did not make a smaller

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(J. Troncone Dec. 1, 1997 Decl. ¶14). A person of ordinary skill in the art of making items for premature infants, with both the Porcaro blanket and all prior art items made for very small infants before him, could find a 14" x 18" Porcaro blanket obvious as a solution to the problems of pacifying such an infant and providing a blanket which would not get entangled in the infant's limbs or infant furniture. However, the Court need not make this determination in order to resolve this motion, and declines to do , so.

size blanket until Nordstrom requested it (Seifert Depo. 90:12-92:3) does not contradict obviousness.

Finally, Comfort Silkie argues that elements of the '285 patent other than size were not obvious to Seifert or to one of ordinary skill in the art. (See, e.g., Pl.'s Opp. 9:26-28; Meisenholder Decl. ¶5, 7, 10.) Such arguments are irrelevant. All claims of the '285 patent containing non-size-related elements have been invalidated on the basis of public use. It thus is not germane, even if true, that persons of ordinary skill in the art are unaware of "fetal behaviors" (Pl.'s Opp. 9 28-12:17) or the pacification properties of flannel and satin (P1.'s Opp. 15:18-24; Meisenholder Decl. ¶6-7). Currently before the Court is a motion for invalidity of dependent Claims 5 and 11 based on Obviousness of those claims in the light of prior art. There is no burden on Seifert to show that the invalidated elements of the '285 patent were "obvious" to Seifert or to anyone else. Plaintiff's insistence that the invention be viewed "as a whole" does not impose a different requirement, as the invention is viewed "an a whole" in the light of prior art.

5. Objective Evidence of Obviousness or Nonobviousness

Objective evidence such as commercial success, failure of others, long-felt need, and unexpected results must be considered before a conclusion on obviousness is reached. Hybritech v. Monoclonal Antibodies. Inc., 802 F.2d 1367, 1379 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

In re Pro-Mold, the patent holder's evidence of commercial success provided sufficient indicia of nonobviousness to withstand say Judgment of invalidity, even though two prior art references together contained all the elements of the patented device (an athletic card holder), and the reason to combine the elements arose from the nature of the subject matter itself (athletic cards). Pro-Mold, 75 F.3d at 1573. The Court held that the patent holder's sale of 3.2 million card

holders in the first year it was offered "provided support for a nexus between these sales and the claimed invention." Id. Specifically, the Court reasoned that

> [The patent-holder's] lack of previous experience in the relevant market combined with its high sales of the patented product provided an inference of a nexus between it's commercial success and the patented invention and are thus probative evidence of nonobviousness.

Pro-Mold, 75 F.3d at 1574. The patent-holder also submitted affidavits from fourteen distributors stating that the patented item "began selling rapidly and in large quantities as soon as it was introduced to the market." Pro-Mold, 75 E.3d at 1574. The patent-holder also submitted evidence of industry acceptance, copying by others, and three licensing agreements with competitors. Id.

The objective evidence of nonobviousness in Pro-Mold therefore comprised the patent-holder's lack of experience in the relevant market, its great and immediate commercial success with the patented invention; evidence from third parties that the patented item sold rapidly and in large quantities immediately upon introduction (indicating "long-felt need," under Hybritech, supra); and evidence of industry acceptance, copying, and licensing agreements.

In this case, Comfort Silkie's objective evidence of nonobviousness includes gradually increasing sales of blankets covered by Claims 5 and 11 and industry acceptance of the items.

a. Evidence of Commercial Success

Comfort Silkie has been in business selling the small blankets since-1989. (J. Troncone Decl. ¶12.) Plaintiff's sales were 9000 small blankets in 1989, the year of introduction, rising

to 38,000 in 1997. (G. Troncone Decl. 17.)[7] Comfort Silkie itself argues that "Initial attempts to sell the Silkie were resisted,)' although the argument is unsupported by citations to evidence. (Pl.'s Opp. 19:10-11.)

b. Industry Acceptance

Comfort Silkie presents evidence that the Comfort Silkie blanket is used in many hospitals, particularly neonatal units (J. Troncone Decl. ¶4). In 1991, the small blanket was one of twelve finalists in what appears to be an annual juvenile products competition (J. Troncone Decl. ¶16, Exh. E). The small blanket received a 1995 "Seal of Approval" in a testing process available to all manufacturers of products for children. (J. Troncone Decl., Exh. D.) This degree of recognition demonstrates "industry acceptance," however it is not comparable to that received by the animal trap in Woodstream Co. v. Herter's Inc., 446 F.2d 1143 (8th Cir. 1971), whose nonobviousness was supported by its receipt of the "only award ever given" by the American Humane Association.

The small blanket has been mentioned in trade publications (J. Troncone Decl. ¶16, Exh. F). While Particles commenting favorably upon a patented product. . . .may be direct technical evidence of non-obviousness," Jenn-Air Corp. v. Modern Maid Co., 499 F. Supp. 320 {D.Del. 1980), aff'ed 659 F.2d 1068 (3rd Cir. 1981), what Comfort Silkie has presented are not articles by independent, technically-sophisticated third parties, but directory listings and short "blurbs" about the product in magazines directed primarily at retailers.

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[7] Plaintiff has requested that this Declaration be placed under seal, presumably because it contains sales figures.

C. Copying and Licensing Agreements

Comfort Silkie has presented no admissible evidence of copying other than alleged against Seifert.[8] Comfort Silkie has presented no evidence of licensing agreements or other interest by other blanket manufacturers in a product like Claims 5 and 11, other than inadmissible hearsay about other manufacturers' interest in the product.

D. Disbelief by Expert.

Although the argument is in tension with Comfort Silkie's argument for nonobviousness based on commercial success, Comfort

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[8] The evidence of copying presented by Comfort Silkie is found at J. Troncone 2nd Decl. ¶16-18. Jeanelle Troncone testified that "it was not until 1995 after seeing the Comfort Silkie at a trade show. . . that Patch Graft introduced a small blanket" (¶16); "Both Fun Furnishings and Sensational Beginnings have recently begun to copy [Claims 5 and 11]" (¶17); "Well after the introduction of the Comfort Silkie and after the Comfort Silkie was well publicized and generally accessible in the juvenile products industry, Right Start advertised a similar blanket" (¶18); "there was at least one other supplier who produced an imitation of the Comfort Silkie whom I was able to talk out of infringing" (¶18); "several other manufacturers. . L .have let us know that they are quietly sitting on the sidelines. . .so that they too can copy the Comfort Silkie" (¶18). The actual alleged copies have not been offered into evidence, nor have photographs been offered. No testimony has been submitted; from any alleged "copier." J. Troncone has no foundation for her claims of "copying," and to the extent these claims are based on alleged admissions to her, they are hearsay and inadmissible.

Silkie also argues that the initial lack of acceptance of the small blanket supports nonobviousness, relying on U.S. v. Adams, 383 U.S. 39 (1966)

In Adams, which concerned a battery, the Supreme Court stated' "at the time Adams perfected his invention noted experts expressed disbelief in it. Several of the same experts subsequently recognized the significance of the Adams invention, some even patenting improvements on the same system." U.S. v. Adams, 383 U.S. at 52.

Adams is distinguishable. In Adams, the disbelief of experts was a minor factor supporting nonobviousness., mentioned by the Court only after it concluded that the invention was nonobviousness on the bases that "the operating characteristics of the Adams battery have been shown to have been unexpected and to have far surpassed then-existing. . . batteries," and the invention required "ignor[ing]. . . .long-accepted" principles in making batteries. Adams, 383 U.S. at 51-52. Comfort Silkie has presented no evidence of unexpected results, nor that the invention somehow contradicted prior art. Moreover, the "disbelief" in Adams was disbelief in the technical feasibility of the invention, not in its marketability. Experts in the field doubted whether the battery would work, not whether anyone would buy it. What Comfort Silkie has presented is evidence of the skepticism of a handful of unnamed retailers as to the commercial viability of a very small blanket. (J. Troncone 2nd Decl. ¶2-3, 5, 7; Meisenholder Decl. ¶8 ("a security blanket that was too small to function as a blanket. . .certainly would not be a viable commercial design")[9]). Even if, a. plaintiff's counsel argued

[9] Even if, as plaintiff's counsel argued at oral argument, there was evidence of skepticism as to the usefulness of the 14" x 13" items as blankets for warmth, there is no evidence that items of this size are not suitable as security items. The Fisher-Price security bunny is an example of such an item.

at oral argument, there was evidence of skepticism as to the usefulness of the 14" x 18" items as blankets for warmth, there is no evidence of skepticism regarding the use or items of this size as security items. The fact that certain retailers may have been wrong about the small blanket's commercial viability, or may have misunderstood the intended use of the smaller blanket, does not render the invention nonobviousness, nor does the fact that those retailers may now sell the item.

C. Conclusion as to Obviousness

Plaintiff's objective evidence of nonobviousness ultimately consists simply of Comfort Silkie's moderate success selling small satin and flannel blankets over an eight-year period. This does not raise a genuine issue of material fact as to the nonobviousness of making a small, Porcaro-style blanket, in the light of prior art reference. which collectively include all the elements of Claims 5 and 11; evidence that making a smaller blanket is obvious to one of ordinary skill in the art; evidence that the Fisher-Price item provides the reason, suggestion or motivation to make a small-size Porcaro-style blanket; and the relatively slight innovation required to make a blanket of a different size.[10] Because the claimed invention

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[10] Perhaps fearing that this Court would improperly rely solely on it. own judgment in this determination, Comfort Silkie needlessly reminds the Court that "Judges are not constitutionally empowered to legislate their individual subjective views respecting degrees of inventiveness. . . .[I]t is not what the judge thinks is the proper degree of inventiveness [which determines obviousness]. (Pl.'s Opp. 16:16-19.) Comfort Silkie is reminded that the determination of whether a reference or a combination of references renders a claimed invention obvious under §103 is a question of law. In re GPAC, 57 F.3d 1573, 1577 (Fed.Cir. 1995).

(Claims 5 and 11) involves nothing more than making an already-invented blanket in the size of an already-invented security item for infants, the factual inquiries into obviousness present no genuine issue of material fact. Under Ryko Mfg. Co. v. Nu-Star. Inc., 950 F.2d 714 (Fed. Cir. 1991), defendant's motion for summary judgment of invalidity of Claims 5 and 11 of the '285 patent is therefore GRANTED. Claims 5 and 11 of the '285 patent are therefore INVALID FOR OBVIOUSNESS, pursuant to 35 U.S.C. §103.

IV. PLAINTIFF'S MOTION AND CONCLUSION

Defendant's motion to invalidate Claims 5 and 11 of the '285 patent on the basis of obviousness is GRANTED. On this basis, plaintiff's motion for damages and other relief based on alleged infringement of Claim. 5 and 11 is MOOT and need not be determined.

IT IS SO ORDERED.

Dated: May 26, 1998

LOURDES G. BAIRD, United States District Judge

## APPENDIX 3 - MEMORANDUM OF THE FEDERAL DISTRICT CIRCUIT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA DATED MARCH 31, 1998.

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| COMFORT SILKIE CO. CORP.<br>Plaintiff,<br><br>v.<br><br>ANNETTE SEIFERT dba BAREFOOT DREAMS,<br>Defendant. | CV 96-6341 LGB<br><br>ORDER GRANTING IN PART AND DENYING IN PART PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT OF INFRINGEMENT |
| ANNETTE SEIFERT dba BAREFOOT DREAMS,<br>Counterclaimant,<br><br>v.<br>COMFORT SILKIE CO. CORP.<br>Counterdefendant. | ORDER GRANTING IN PART AND DENYING IN PART DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF INVALIDITY AND NON-INFRINGEMENT |

### I. INTRODUCTION AND BACKGROUND

Plaintiff's and defendant's cross-motions for summary judgment came on regularly for hearing on March 30, 1998. Having carefully considered the papers filed and oral argument of counsel, the Court hereby GRANTS IN PART AND DENIES IN PART plaintiff's motion for summary judgment of patent infringement. The Court hereby GRANTS IN PART AND DENIES IN PART defendants

Motion for summary Judgment of invalidity and non-infringement.

This case arises from a dispute between two makers of blanket for infant, one of whom holds a patent. Currently before the Court are cross-motions for summary judgment regarding infringement. Defendants motion also raises the defense of the invalidity of the patent.

Plaintiff Comfort Silkie Corporation ("Comfort Silkie") is the holder of U.S. Patent 4,989,285 ("the '285 patent"), a patent for a "Security Blanket With Tactile Characteristics Simulative of the Amnion and Amniotic Fluid"--that is, a baby blanket whose two sides slide when rubbed between thumb and forefinger. The inventors of the patent are Jeanelle and Gregory Troncone; Comfort Silkie is their business. The application which led to the '285 patent was filed with the United States Patent and Trademark Office on June 19, 1989.

Defendant Annette Seifert dba Barefoot Dreams ("Seifert") also manufactures and sells baby blankets. (Seifert'. Facts l and 2.) These blankets are rectangular in shape, and consist of two adjacent sheet. of material, one 100% organic cotton flannel, and the other washable satin. (Seifert's Fact 5.) A washable satin panel is sewn to the flannel aide of Seifert's blankets and bears the name "Barefoot Dreams," Seifert's dba.

On September 10, 1996, Comfort Silkie filed its Complaint against Seifert alleging infringement of the '285 patent. On April 30, 1997, Seifert filed her Answer and Counterclaims, seeking (l) declaratory judgment of invalidity and noninfringement and (2) injunctive and monetary relief for false advertising pursuant to 15 U.S.C. §1125 (a). The second of these claims we. dismissed with prejudice by stipulation of the parties February 12, 1998.

On November 7, 1997, Seifert filed a Motion for Summary Judgment of Noninfringement on the basis that Seifert's blankets do not infringe the '285 patent.[1] On December l, 1997, plaintiff Comfort Silkie filed its Opposition and Cross-Motion for Summary Judgment (a single filing)[2] On December 5, 1997, Seifert filed an Ex Parte Application under Rule 56(f) for continuance of the hearing of the cross-motions, which was granted by Minute Order December 12, 1997.

On January 20, 1998, Seifert filed an Opposition to Comfort Silkie's summary judgment motion, which Seifert also apparently intends to serve as a Reply in support of defendant

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[1] Seifert's motion does not state whether this i. a motion for summary judgment on Comfort Silkie's claim of patent infringement against Seifert, or on Seifert's own counterclaim for declaratory judgment of noninfringement. This Memorandum treats Seifert's motion as a motion for summary judgment troth on Comfort Silkie's claim tint on Seifert's counterclaim.

[2] Comfort Silkie'. filing (a combined Opposition and motion for summary judgment) also does not state whether Comfort Silkie is opposing summary judgment on its own claim, or on Seifert'. counterclaim. Nor does it state whether Comfort Silkie is moving for summary judgment on its own claim of patent infringement, or on Seifert's counterclaim for declaratory Judgment of noninfringement. This Memorandum will treat Comfort Silkie as simultaneously opposing Seifert'- motion for summary judgment as to Comfort Silkie's claim; opposing Seifert's motion for summary judgment as to Seifert's counterclaim; moving for summery judgment on Comfort Silkie's claim; and moving for summary judgment on Seifert's counterclaim.

Seifert's motion for summary judgment.[3] On January 26, 1998, Comfort Silkie filed its Reply.[4]

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[3] This Opposition to Comfort Silkie's motion raises the invalidity issue for the first time. It is therefore treated as raising the invalidity defense in opposition to Comfort Silkie's motion for summary Judgment on Comfort Silkie's claim of patent infringement And as raising the invalidity defense in support of Seifert's own motion for summary judgment on Comfort Silkie's claim and on Seifert's counterclaim for declaratory Judgment, now not only of noninfringement but of invalidity as well.

[4] The determination of these motions has been complicated by a variety of procedural irregularities by both parties. Comfort Silkie has presented an Opposition to Seifert's motion which is intended to serve also as its own Motion for Summary Judgment, although no Notice of Motion has been filed. Neither motion for summary judgment makes clear whether the Complaint or the Counterclaim is under discussion. Apart from the procedural irregularity of using a single document to serve as Opposition to Comfort Silkie's motion and Reply in Seifert's own motion, defendant Seifert's Statement of Uncontroverted Facts and Conclusions of Law in support of her motion for summary judgment, and her Genuine Issues of Material Fact in Opposition to Comfort Silkie's motion for summary judgment, are completely devoid of any citation to the evidentiary record in this case. Fed. R. Civ. P. 56(e) requires the party against whom a summary judgment motion is made to Set forth specific facts showing that there is a genuine issue for trial." Local Rule 7.14.2 requires the Statement of Genuine Issues to "Set[] forth all material facts as to which it is contended there exists a genuine issue necessary to be litigated." A Local Rule of this kind serves a. "adequate notice to nonmoving parties that if a genuine issue exists for trial, they must identify that issue

The hearing date of these motions was continued by Minute Orders March 13, 1998 and March 19, 1998 in order to allow the parties to present evidence pertinent to Seifert's "public use" invalidity defense to Comfort Silkie's claim of patent infringement .[5]

II. Applicable legal Standards

A. Summary Judgment

1. In General

Summary judgment shall be granted if the evidence supporting the motion for summary judgment shows that "there is no genuine issue a. to any material fact and that the moving party is entitled to a judgment as a matter of law."

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and support it with evidentiary materials without the assistance of the trial judge." Nilsson, Robbins et al. v. Louisiana Hydrolec, 854 F.2d 1538, 1545 (9th Cir. 1988) (emphasis added). Absent such a showing, a properly supported motion for summary judgment, in which the moving party has met its burden, may be granted. Id. Plaintiff's Statement of Genuine Issues is not satisfactory under Local Rule 7.14.2, Fed. R. Civ. P. 56(e), and Nilsson Robbins. As a result, in determining Comfort Silkie's motion, the Court is permitted to "rely[] on the evidence designated by [the moving party] in their motion," under Guarino v. Brookfield Township Trustees, 980 F.2d 399, 403 (6th Cir. 1992).

[5] Because the Porcaro Deposition has been lodged with the Court March 19, 1998, the Court will not consider the Painter Declaration filed by Seifert March 12, 1998; the Objection to the

Fed. R. Civ. P. 56(c). A party moving for summary judgment may carry its initial burden by pointing out to the district court that there is an absence of a genuine issue of material fact. Cortex Corn. v. Catrett, 477 U.S. 317, 323 (1986). "The plain language of Rule 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." Celotex, 477 U.S. at 322. If the non-moving party bears the burden of proof at trial, the moving party may carry its burden by showing an absence of evidence to support the non-moving party' case. Ceded a, 477 U.S. at 323.

Painter Declaration filed by Comfort Silkie March 16, 1998; the Declaration of Jeanelle Troncone filed by Comfort Silkie March 17, 1998; or the Objections to the Troncone Declaration filed by Seifert March 18, 1998, all of which pertain to the contents of the Porcaro deposition. The Court's Minute Order provided the parties the opportunity to submit additional "evidence" on the issue of public use. On March 17, 1998, Seifert filed a "Supplemental Memorandum" addressing invalidity, to which Comfort Silkie filed "Objections to Defendant's Supplemental Memorandum" on March 18, 1998. This supplemental briefing has not been considered by the Court in determining the cross-motions before

To avoid summary judgment, the non-movant must set forth specific facts showing that there remains a genuine issue of material fact for trial. Celotex, 477 U.S. at 324. The non-movant "may not rest upon the mere allegations or denials of the adverse party's pleading." A factual dispute is "genuine" if a reasonable jury could return a verdict for the nonmoving party. Anderson v Tibet Lobbed Inc., 477 U.S. 242, 248 (1986). The evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in the non-

movant's favor. Id. at 255. If the nonmoving party's evidence is merely colorable or in not significantly probative, then summary judgment may be granted. Id. at 249-50.

District courts "possess the power to enter summery judgment sue sponte, so long as the losing party was on notice that she had to come forward with all of her evidence.. Celotex, 477 U.S. at 326. Where one party moves for summary judgment and at the hearing the court determines there is no genuine issue of material fact and the opposing party in entitled to judgment as a matter of law, sua sponte judgment in favor of the opposing party is appropriate so long as the losing party Shad a full and fair opportunity to ventilate the issues involved in the motion." Cool Fuel. Inc. v. Connett, 685 F.2d 309, 311-12 (9th Cir. 1982).

2. In the Patent Context

When supported by the facts and law, summary judgment is appropriate in patent case.. See. e.g., Barge Marimba Maschinenfabrik AG v. Murata Mach . Ltd., 731 F.2d 831 (Fed. Cir. 1984).

The burden is on the patent holder to prove infringement by a preponderance of the evidence. Mannesmann, 793 F.2d at 1282. The patent holder may prevail by establishing infringement of one or more claims. Richardson v. Suzuki Motor Co., 868 F.2d 1226,1238 (Fed. Cir.), cert. denied, 493 U.S. 853 (1989). When an accused infringer seeks summary judgment of noninfringement, the non-movant patentee has the burden to establish the existence of disputed material facts. Morton Int'1, Inc. v. Carding Chemical Con, 5 F.3d 1464, 1468 (Fed. Cir. 1993); Gentex v. Donnelly Corn., 31 U.S.P.Q.2d 1189, 1191 W.D. Mich. 1994).

Patents are presumed valid. 35 U.S.C. §282 (1988). The presumption of validity afforded by §282 places the burdens of going forward and of persuasion on the party asserting

invalidity. The party asserting invalidity must establish, by clear and convincing evidence, facts which support the ultimate legal conclusion of invalidity. Checkpoint Systems v. U.S. Intern. Trade Com'n, 54 F.3d 756 (Fed. Cir. 1995). For example, a district court can properly grant a motion for summary judgment I on patent invalidity when the factual inquiries into obviousness present no genuine issue of material fact. Ryko Mfg. Co. v. Nu- Star, Inc., 950 F.2d 714 (Fed. Cir. 1991).

The production of evidence of prior art not considered by the Patent and Trademark Office may carry more weight as the district court is not called upon to disagree with the PTO or required to defer to it an to the effect of that evidence upon the validity of the patent. American Hoist & Derrick Co. v. Sowa & Sons, 725 F.2d 1350, 1369-60 (Fed. Cir. 1984).

B. Patent Infringement Standards

Literal infringement requires that the accused device embody every element of the patent claim. Mannesmann Demag Corp. V. Engineered Metal Prods., 793 F.2d 1279, 1293 (Fed. Cir. 1986). Failure to meet a single claim limitation negates infringement. Laitram Corm. v. Rexnord. Inc., 939 F.2d 1533, 1535 (Fed. Cir. 1991). However, if the accused device does embody every element of the claim, it is irrelevant whether the accused device also includes any additional elements not contained in the claims. Mannesmann, 793 F.2d at 1282-83.

The law is well-established that determining whether patent claims have been literally infringed requires a two-step analysis. Markman v. Westview instruments, Inc., 116 S.Ct. 1384, 1393 (1996); Mannesmann, 793 F.2d at 1282. The first step is the proper construction of the asserted claims. Vitronics Corp. v. Conceptronic. Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996); Markman, 116 S. Ct. At 1393. This first

step, termed claim construction, is a question of law for the court. Markman. 116 S.Ct. at 1393.

In construing the claims, the starting point is the language of the claims themselves. North American Vaccine v. American Cyanamid Co., 7 F.3d 1571, 1575 (Fed. Cir. 1993); Vitronics, 90 F.3d at 1582. In construing a claim, claim terms are given their ordinary and accustomed meaning unless examination of the specification, prosecution history, and other claims indicates that the inventor intended otherwise. Nike Inc v. Wolverine World Wide Inc., 43 F.3d 644 (Fed. Cir. 1994). In resolving a dispute as to the interpretation of a claim, the court may also refer to extrinsic materials. Mannesmann, 793 F.2d at 1282. However, where there is no ambiguity in the claim language, courts should read the claim alone as the measure of the invention. National Bus. Systems Inc. v. AM Int'l, Inc., 546 F.Supp. 340, 348 (N.D.Ill. 1982), aff'd, 743 F.2d 1227 (7th Cir. 1984). Moreover, where the specification does not require a limitation, that limitation should not be read from the specification into the claims. Maxwell v. Baker, 39 U.S.P.Q. 2d 1001 (Fed. Cir. 1996).

The second step of the analysis, comparing the properly construed claims to the accused device in order to ascertain infringement, is a question of fact. Markman, 116 S.Ct. at 1393.[6]

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[6] Comfort Silkier repeated exhortation. to the Court to "simply compar[e] the blankets" made by plaintiff and defendant(e.g. at Comfort Silkie's Opp./Mot. 3:8, 9:22) produced by plaintiff and defendant therefore misstates the standard for patent infringement, which requires the Court to compare the accused device with the Latent clammy, not with articles produced r by the patent holder.

Even if an accused device does not literally infringe: upon the express terms of a patent claim, it may still be found to infringe the patent under the "doctrine of equivalents." Warner-Jenkinson Co. v. Hilton Davis Chem., 117 S.Ct. 1040, 1045 (1997). Under this doctrine, infringement exists if there is an equivalence between the elements of the accused product and the claimed elements of the patented invention. Id. However, mere equivalence overall between the accused device and the patented invention is insufficient; there must be element-by-element equivalence between the two. Id. at 1049, 1054.

A device is "equivalent" if it "performs substantially the same function in substantially the same way to obtain the same result." Lam, Inc. v. Johns-Manville Corp, 668 F.2d 462, 471 (l0th Cir. 1982).

III . CLAIM CONSTRUCTION

A. Claim Language

Plaintiff has a patent on its baby blanket., U.S. Patent 4,989,285 (the "'285 patent"). The '285 patent contains 12 claims, six of which are independent.[7] The dependent claims

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[7] In Comfort Silkie's motion for summary judgment, Comfort , Silkie argues that all twelve claims are infringed. Because dependent claims constitute further limitations of independent claims, under 35 U.S.C. 112, unless a device infringes an independent claim, it cannot, a fortiori, infringe a dependent claim. See, e.g., Carroll Touch, Inc. v. Electro Mech. Sys., Inc, 15 F.3d 1573, 1576 (Fed. Cir. 1993). Therefore, the analysis will first address the independent claims, and address the dependent claims only as it becomes necessary to do so.

are set out below in square bracket. The claim language is as follows:

1. An apparatus for providing pacification to an infant by tactile simulation of an amniotic environment comprising: a first textile sheet having a first typo of tactile characteristic and having a peripheral boundary; a second textile sheet having a second type of tactile characteristic and having a peripheral boundary, said first and second sheets selectively coupled together to allow slipping of said first and second sheets with respect to each other when manually manipulated by said infant, so that said apparatus is tactilely simulative of said amniotic environment, wherein said first and second sheets, have a common peripheral boundary and are connected together only at their common peripheral boundaries. ('285 patent, Col. 4, 11.28-42.)

[2. The apparatus of claim 1 wherein said first tactile characteristic is distinct from second tactile characteristic, but wherein sliding friction between said first and second sheets is low on account of said first and second tactile characteristics of said sheets.]

[3. The apparatus of claim 2 wherein said first and second sheets can be pressed together and slid with respect to each other by manual manipulation with a co-efficient of sliding friction therebetween to simulate the sliding of two flexible layers with an interlying liquid layer.]

[4. The apparatus of claim 1 wherein said first and second sheet can be pressed together and slid with respect to each other by manual manipulation with a co-efficient of sliding friction therebetween to simulate the sliding of two flexible layers with an interlying liquid layer.]

[5. The apparatus of claim 1 used in combination with infant furniture wherein said first and second sheets are generally

rectangular with dimensions of 14 inches by 18 inches or less to avoid entanglement with said infant and infant furniture.]

6. An apparatus for providing pacification by tactile simulation of an amniotic environment comprising: a first textile sheet having a first type of tactile characteristic and having a peripheral boundary; a second textile sheet having a second type of tactile characteristic and having a peripheral boundary, said first and second sheets selectively coupled together to allow slipping of said first and second sheets with respect to each other when manually manipulated by said infant, so that said apparatus is tactilely simulative of said amniotic environment, wherein said second sheet i. satin and wherein said first sheet is flannel, and wherein said first and second sheets, have a common peripheral boundary and are connected together only at their common peripheral boundaries. ('285 patent, Cal. 4, 1.-65-Col. 5, 1. 13.)

7. An apparatus for providing pacification by tactile simulation of an amniotic environment comprising: a first textile sheet having a first type of tactile characteristic and having a peripheral boundary; a second textile sheet having a second type of tactile characteristic and having a peripheral boundary, said first and second sheets selectively coupled together to allow slipping of said first and second sheets with respect to each other when manually manipulated by said infant, so that said apparatus is tactilely simulative of said amniotic environment, wherein said second sheet is satin and wherein said first sheet is flannel, wherein said second sheet is satin and wherein said first sheet is flannel brushed on both side., and wherein said first and second sheet., have a common peripheral boundary and are connected together only at their common peripheral boundaries. ('285 patent, Col. 5, 11. 14-32.)

8. An apparatus for providing pacification by tactile simulation of an amniotic environment comprising: a first textile sheet having a first type of tactile characteristic and

having a peripheral boundary; a second textile sheet having a second type of tactile characteristic and having a peripheral boundary, said first and second sheets selectively coupled together to allow slipping of said first and second sheets with respect to each other when manually manipulated by said infant, so that said apparatus is tactilely simulative of said amniotic environment, wherein said second sheet in satin and wherein said first sheet is flannel, and further comprising a common peripheral boundary of said first and second sheets, and boundary layer substantially circumscribing said common peripheral edges of said first and second sheets, said boundary layer having a predetermined tactile characteristic. ('285 patent, Col. 5, 1.33-Col. 6, 1. 2.)

9. An apparatus for providing pacification by tactile simulation of an amniotic environment comprising: a first textile sheet having a first type of tactile characteristic and having a peripheral boundary; a second textile sheet having a second type of tactile characteristic and having a peripheral boundary, said first and second sheets selectively coupled together to allow slipping of said first and second sheets with respect to each other when manually manipulated by said infant, so that said apparatus is tactilely simulative of said amniotic environment, wherein said second sheet is satin and wherein said first sheet is flannel, and further comprising a common peripheral boundary of said first and second sheets, and a textile boundary layer substantially circumscribing said common peripheral edges of said first and second sheets, said boundary layer having a predetermined tactile characteristic. ('285 patent, Col. 6, 11. 3-21.)

[10. The apparatus of claim 9 wherein said first tactile characteristic is distinct from said second tactile characteristic, but wherein sliding friction between said first and second sheets is low on account of said corresponding first and second tactile characteristics of said sheets]

[11. The apparatus of claim 10 wherein said first and second sheets are generally rectangular with dimensions of 14 inches by 18 inches or less.]

12. A security blanket for use by an infant for pacification and comfort comprising: first means for providing a first tactile characteristic; second means coupled to said first means for providing a second tactile characteristic, said first and second means being manually disposable in frictional sliding engagement with each other by said infant, said first and second means having a relative co-efficient of sliding friction with respect to each other simulative of fluidic friction; wherein said first means is comprised of a sheet of brushed flannel and said second means is comprised of a sheet of chartreuse satin, said first and second means having a common Outer periphery, said first and second sheets being bound together only at said outer common periphery, whereby a security blanket having a tactile feel suggestive of amnion lining and amniotic fluid is provided. ('285 patent, Col. 6, 11. 30-49.)

B. Identification and Interpretation or Claim Elements

The interpretation of the claims given here will be applicable for the purposes of both validity and infringement analyses. Smithkline Diagnostics v. Helena Laboratories Corp., 859 F.2d 878, 882 (Fed. Cir. 1988).

(A complete table of the claim elements in each of the 12 independent and dependent claims of the '285 patent is attached as Appendix A.)

All the claims of the `285 patent include the following elements:

(1)[8] that the device is an apparatus "providing" or "for providing" pacification to an infant;

(2) "by tactile simulation of an amniotic environment" (or "a tactile feel suggestive of amnion lining and amniotic fluid") ;

(3) comprising two textile sheets of different tactile properties;

(4) connected together at their common periphery;

(5) to allow "slipping" when "manually manipulated by said infant" (in other word., when fingered by a baby).

Element (1) appears before the word "comprising" in each of the claims. Such prefatory language is ordinarily not construed as part of the claimed invention, which includes only those elements following the word "comprising". See. e.g., Bio-Rad Laboratories v. Nicolet Instrument Corp., 739 F.2d 604, 608-610 (Fed. Cir. 1984); Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1574 (F d. Cir. 1995).

Element (2) appears in Claims 1 through 11 both before and after the word "comprising". A somewhat different from of element (2) appears in Claim 12. Element (2) as it appears in Claim 1 through 11 requires that the blankets provide "tactile simulation of an amniotic environment." Webster's Dictionary defines "tactile" as "perceptible to the touch." Webster's II New Riverside Dictionary at 1178 (1988). The same dictionary defines "simulation" an "imitation" and "false appearance." Webster's at 1086. The "tactile simulation" of the amniotic environment therefore requires an imitation of that environment with respect to the sense of

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[8] For purposes of this discussion, claim elements will be numbered consecutively for ease of discussion.

touch. The definition of "simulation" as "false appearance" permits a simulation to differ from the item simulated in significant ways.

It is not disputed that amniotic fluid is a liquid, and that a blanket is a dry textile. (Seifert Depo. 34:19-36:2, 42:2343:1, 44:15-20.) However, wetness is not the only salient characteristic of the Amniotic environment. Undisputed evidence has been presented that the amniotic environment is "silky" (due to the amniotic lining and the presence of vernix caseosa) and "warm" (as it is maintained at the mother's body temperature). (Troncone Decl. ¶10; Troncone Depo. 16:16-17:1; 37:20-39:6; 40:10-41:13, 42:10-45:3, 49:7-17; Sanders Decl. ¶3.) Comfort Silkie has presented evidence that the satin and flannel , combination simulates this silkiness. (Troncone Decl. ¶11; I Sander. Decl. ¶3, 4.) Therefore, although the amniotic environment is aqueous, and a blanket is a dry textile, this is not sufficient to prevent the blanket from "tactilely simulating" the amniotic environment as a matter of law, so long as it imitate. it in ways perceptible to the touch. Element (2) as it appears in Claims 1 through 11 is therefore satisfied by a blanket which is warm and silky to the touch.

The language in Claim 12 expresses element (2) somewhat differently. Claim 12 requires that the blanket have a "tactile feel suggestive of amnion lining and amniotic fluid." Webster's defines "suggestive" as "tending to suggest thoughts or ideas; conveying a suggestion or hint," and states that the "core meaning" of "suggestive" and related synonym. "allusive," "evocative," "impressionistic," and "reminiscent" is "tending to bring something, as a memory, mood, or image, subtly or indirectly to mind." Webster's at 1158. This is a lesser requirement than "simulation," as an item may "convey a hint" of another without being an "imitation" of it. On this basis, a silky blanket satisfies the requirement that it be "suggestive" of amnion lining and amniotic fluid. The element of Claim 12 which refers to a feel "suggestive of

amnion lining and amniotic fluid" is therefore satisfied by a silky blanket.

Seifert has presented the testimony of Dr. Bates that there is "no credible research whatsoever. . .that the interface between layers of satin and flannel will simulate the interface between amniotic fluid and the amnion lining."(Bates Decl. ¶4.) She has also presented evidence that she herself does not understand how a textile blanket can be the Samoa or alike wet amniotic fluid. (Seifert Depo. 34:19-36:2, 42:23-43:1, 44 15-20.) This testimony does not undermine the claim interpretation set out above. Claims 1 through 11 do not require simulation specifically of the amniotic fluid/amnion lining interface, or that the blanket and the amniotic environment be the "same" but only that there be simulation of the amniotic environment more generally, which, as stated above, can be accomplished by a warm, silky blanket. By the same token, Claim 12 does not require that the blanket be "simulative" of the amniotic fluid/amnion lining interface, or that the two be the "same," but only that the blanket be "suggestive" of the amniotic tissues, a much weaker requirement, which can be met by any silky blanket. Element (2) as it appears in Claim 12 is therefore satisfied by any silky blanket.

Elements (3), (4), and (5) together require that the blanket be constructed of two sheets of different fabrics, one on top of the other, sewn together around their common periphery, so that the sheets slide when stroked or pinched between finger and thumb.

1. Analysis of Independent Claims

The multiple independent claims of the '285 patent also have an overlapping patchwork collection of other elements. Claims 1, 6, 7, ant 12 require:

(6) that the two sheets be connected only at their periphery. Claims 8 and 9 do not.[9]

Claims 6, 7, 8, 9, and 12 add:

(7) that one sheet be satin[10] and the other, flannel.

Claims 7 and 12 add:

(8) that the flannel sheet is brushed on both sides.

Claim 12 further adds:

(9) that the satin sheet is charmeuse satin.

Claims 8 and 9 also require:

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[9] In Seifert's motion for summary judgment, she argues that the requirement that the two sheets be connected only at the periphery should be "read in. to Claim. 8 and 9. This argument is based on reference to the specification and the prosecution history. However, such reference is only appropriate when there is ambiguity in the claim or a dispute about the meaning of a term in a claim, under Nike, Mannesmann, and Net', Bus Systems, supra. That is not the case here.

[10] Seifert attempts to distinguish her blankets from Comfort Silkie's on the basis that her blankets unto natural "acetate satin" while Comfort Silkie's use "a synthetic, polyester satin." (Supp. Seifert Decl.¶18(d).) Because the '285 does not specify either acetate or polyester satin, this difference is irrelevant under Mannesmann", supra.

(10) a border around the edges of the blanket.

Claim 9 further requires:

(11) that the blanket's border be a textile.

Claim 12 requires that the "slipping" in (5) above be due to the satin and flannel having

(13) a relative co-efficient of sliding friction simulative of fluidic friction.

Claims 1, 6, 7, 8, and 9 lack this specific "fluidic" reference.

Seifert argues that the term "peripheral boundary" (element (4) in all the '285 claims) can only be understood by reference to the specifications of the patent, which mention a maximum or preferred size of 14. x 18" in several places.[11] Seifert is correct that the meaning of the phrase "having a peripheral boundary", which appear. in the claims as a description of the textile sheets comprising the blanket, does not, without more, have a clear meaning. To the extent that all sheets of fabric are of finite Anion, all textile sheets "hav[e] a peripheral boundary," and the phrase standing alone is without meaning.

However, the patent specifications are not a. clear as Seifert suggests they are that the intended meaning of the "peripheral boundary" is that the size of the sheets is to be 14" x 18".

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[11] The detailed Description of the Preferred Embodiment" of the patented device states that "The sheets preferably are formed as a rectangle 14 by 18 inches" ('285 patent, Cal. 2. 1.51; see also Col. 2, 1.57.) The "Brief Summary of the Invention" states "The first and second sheets are generally rectangular with dimensions of 18 inches by 14 inches or less." ('285 patent, Col. 2., 1.15-17.)

These dimensions are mentioned, but the specifications also state that "many alterations and modifications may be made by those having ordinary skill in the art without departing from the spirit and scope of the invention." ('285 patent, Col. 4, 1. 11-14.) There is a general statement that "No attempt is made to provide a blanket having a size adequate to cover or provide warmth to the body of the infant or toddler. . . .a smaller than body size is preferred to avoid tangling." ('285 patent, Col. 3, 1.2-6.) The specifications express a concern that a "[m]aterially larger size[] causes the satin to bag or hang away from the flannel thereby detracting from the desired effect. The bagging can be avoided by quilting or stitching, but only at a loss of the tactile fluidic sensation." ('2BS patent, Col. 2, 1. 59-63.) But the specifications go on to state, wit must be understood that other dimensions or shapes. . .could be utilized if within the teachings of the specification without departing from the spirit and scope of the invention.. ('285 patent, Col. 2, ll. 63-65 (emphasis added).) A blanket considerably larger than 14. x 18. could still be smaller than the body size of a toddler. At most, the specifications lead to a claim construction requiring the blanket to be of such a size as to preserve the "tactile fluidic sensation. without excessive bagging. Where specifications do not require a limitation, that limitation should not be read from the specification into the claims. Maxwell v Baker, 39 U.S.P.Q. 2d 1001 (Fed. Cir. 1996). The specifications of the '285 patent do not require a limitation to 14" x 18", and no such limitation will be read into the patent.

Seifert also argues that element (2) as it appears in Claims 1 through 11, the phrase "tactilely simulative of [the] amniotic environment,' should be construed to require that the sheets "fluidly slide when in contact with one another." (Seifert's Mot. 13:10-11.) This argument is based on the statement in the "Brief Summary of the Invention" that the blanket is to have "a tactile feel suggestive of the silky amnion lining and slippery amniotic fluid." ('285 patent, Col.2, 11.28-30.) Even

if Seifert is correct that this phrase is to be interpreted in light of this language from the brief Summary," it leads only to a construction of the claim as requiring a silky, slippery feeling suggestive of a liquid, not as requiring that dry textiles actually "fluidly" slide in contact with one another. Again, the specification does not require a limitation that the tactile simulation of the amniotic environment requires friction equivalent to that found in a liquid or fluid, and under Maxwell, ! supra, no such limitation will be read in.

2. Additional Dependent Claim Limitations

The dependent claims also add additional limitations. Claim ; 2 adds an additional requirement to independent Claim 1:

(12) that "sliding friction" between the two sheets is "low." 7 Dependent Claim 10 adds the same element to independent Claim 9.

Dependent Claim 3 adds to Claim 2:

(13) the two sheets have "a co-efficient of sliding friction" which "simulate[s] the sliding of two flexible layers with an interlying liquid layer."

Dependent Claim 4 adds element (13) to Claim 1, but does not include element (12).

Dependent Claim 5 limits Claim 1 to

(14) a blanket no larger than 14" x 18" in size, and dependent Claim 11 adds this size limitation to Claim 10.

## IV. INVALIDITY ARGUMENTS

In Opposition to Comfort Silkie's motion for summary judgment, Seifert argues that the '285 patent is invalid.[12] Seifert makes three invalidity arguments: two under 35 U.S.C. §112, based on indefiniteness and lack of enablement; and one under 35 U.S.C. §102 (b), based on public use.

### A. 35 U.S.C. §112

35 U.S.C. §112 provides, in pertinent part, that "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains. . .to make and use the same.

#### 1. Indefiniteness

A patent claim is indefinite when one skilled in the art cannot understand what is claimed when the claim is read in light of the specifications. Haney v. Timesavers, 900 F. Supp. 1378

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[12] In Comfort Silkie's Reply in support of their own motion for augury judgment, Comfort Silkie insists that the only issue before the Court is patent infringement, on the basis that Seifert's motion for summary judgment was addressed to the issue of non-infringement, and Comfort Silkie's cross-motion was addressed solely to the issue of infringement. However, Seifert's Opposition to Comfort Silkie's motion (which also served as a Reply in support of Seifert's own motion), was a proper place to raise the defense of invalidity in opposition to Comfort Silkie's infringement argument. Comfort Silkie had the opportunity to address the invalidity defenses in its Reply, and did so. The issue of invalidity is therefore properly before this Court, and will be addressed.

(D. Or. 1995). If the patent claim., read in the light of the specifications, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise an the subject matter permits, courts should not deem the patent invalid for indefiniteness. Jones Knitting Corp. v. Morgan, 361 F.2d 451 (1966).

Seifert argues that the '285 patent is indefinite, on. the basin of language in the claims referring to flow sliding friction" (Claims 2, 3, 10, and 11); "a co-efficient of sliding friction [between the two textile sheets] to Simulate the sliding of two flexible layers with an interlying liquid layer" (Claim 3 and 4); and Ha relative ca-efficient of sliding friction "between the two textile sheets] simulative of fluidic friction. (Claim 12).

Seifert has presented admissible evidence that neither Troncone nor the patent precisely quantifies "low sliding friction," a phrase which appears in Claims 2, 3, 10 and 11. (Troncone Depo. 59:2-61:17.) Seifert has presented admissible evidence that neither the patent nor Troncone quantifies the specific co-efficient of sliding friction which would simulate "the sliding of two flexible layers with an interlying liquid layer," a phrase which appears in Claims 3 and 4. (Seifert Jan. 16, 1998 Decl., 5:22-24; Troncone Depo. 59:2-61:17.) In her deposition, Troncone testified that she had no evidence about "sliding engagement between layers of satin and flannel." (Troncone Depo. 18:24-20:7.) Seifert has presented evidence that she herself, a person of ordinary skill in the art, Was unable to determine from the disclosure how to make a blanket which exhibited the relationship which plaintiff calls 'fluidic friction,'" a phrase which appears in Claim 12. (Seifert Jan. 16, 1998 Decl., 5:17-19.) Seifert has also presented evidence that Troncone, inventor of the '28S patent, "was unable to quantify what was meant by the coefficient of sliding friction or to provide any specific information on what we. supposedly meant by the term 'fluidic friction.'" (Seifert Jan. 16, 1998 Decl., 5:22-24.)

However, in determining whether the claims are indefinite, I the claims are to be read in the light of the specifications, under Haney, supra. The specifications of the '285 patent explain that, "The sliding coefficient of friction between the two sheets is low and simulative of fluidic friction so that when the sheets are manipulated or stroked by the hand and fingers of an infant, a fluidic or smooth glide is sensed." {'285 patent Abstract and Col. 2, 11. 46-50, emphasis added.) Read in the light of the specifications, the friction between the two sheets need only be such that when manipulated or stroked, a "smooth elide is sensed.- Comfort Silkie has presented evidence of how the patented device exhibits this sliding, and setting out Troncone's understanding of sliding friction in that context. (Troncone Decl. 132, 34; Troncone Depo. 50:13-62:14.) Evidence about indefiniteness as to the relative friction of the two sheets is not dispositive under Haney, supra, where the specifications clarify the allegedly indefinite language, as is the case here. As plaintiff has presented admissible evidence raising a genuine issue of material fact as to the definiteness of the '285 patent claims, Seifert's motion for summary judgment of invalidity as to Claims 2, 3, 4, 10 and 11, and 12 on the basis of indefiniteness should be DENIED.

2. Enablement (35 U.S.C. §112)

To be "enabled" under §112, a patent must contain a description that enables one skilled in the art to make and use the claimed invention. Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd., 927 F.2d 1200, 1212 (Fed. Cir. 1991).

All claims of the '285 patent include as an element that the blanket is "an apparatus [] tactilely simulative of [the] amniotic environment," or equivalent language. Only Claim 12 requires that the blanket have "a tactile feel suggestive of amnion lining and amniotic fluid." ('285 patent, Col. 6, 11. 26- 28.) The other independent claims require only "simulation of an amniotic environment." (See, e.g., '285

patent, Col. 4, 1. 29.) These claim elements have been construed so that the "simulation" claimed is accomplished by any warm and silky blanket. (See III.B, supra.) Thus, the evidence of lack of enablement must demonstrate that one skilled in the art is unable, on the basis of the patent, to make and use a warm, silky blanket, under Amgen, 927 F.2d at 1212.

Seifert has pointed to an absence of evidence that the interface between layers of satin and flannel, as in the '285 patent, will simulate the interface between amniotic fluid and the amnion lining. (Bates Decl. ¶2, 4.) Comfort Silkie has presented admissible evidence of how the patented device simulates the "silkiness" of amniotic tissue stroked by the unborn child and simulate. the amniotic environment (Troncone Decl. ¶10, 11, 12; Troncone Depo. 43:15-44:5, 46:11-49:17.) Given the proper construction of the claims, Seifert has failed to demonstrate that there is no genuine issue of material fact as to whether the patent enables one skilled in the art to make a warm, silky blanket. Seifert's motion for summary judgment of invalidity on the basis of lack of enablement is therefore DENIED.

A. Public use (35 U.S.C. §102(b))

1. Applicable Legal Standards

35 U.S.C. §102 (b) provide., in pertinent part, that A person shall be entitled to a patent unless. . .the invention was. . tin public use. . in this country, more than one year prior to the date of the application for patent in the United States.

A device which consist[s] of substantially the same elements operating in the same manner" and was in public use at the proper date will invalidate the patent under 35 U.S.C. §102(b). See. E.g., Monroe Auto. Equip. Co. v. Heckethorn Manuf., 332 F.2d 406, its (6th Cir. 1964).

An example of a "public use" satisfactory under §102 (b) is an exhibition of an item at a party with friends, by the inventor or another, with no effort made to conceal the device or keep anything about it secret. Beachcombers Int'l. Inc. v. Wildewood Creative Products Inc., 31 F.3d 1154, 1159-60 (Fed. Cir. 1994). A private use for personal enjoyment, which doe. not involve the invention being given over for free and unrestricted use, does not qualify as public use under 1 02 (b). Moleculon Research Corp. v. CBS. Inc., 594 F.Supp. 1420 (D.C.Del. 1984).[13]

The application which led to the '285 patent was filed with the United States Patent and Trademark Office on June 19, 1989, and the relevant date for public use is therefore June 19, 1988. In what follow., each independent claim of the '285 patent will be treated as an "invention" for 35 U.S.C. S102(b) purposes.

2. Evidence of Public Use.

Seifert hat presented admissible evidence that blankets embodying certain elements of the independent claims of the '285 patents were in public use before June 19, 1988 (collectively referred to hereafter as "the Porcaro blankets")[14]

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[13] At oral argument, counsel for Comfort Silkie argued that public use must be enabling. to be invalidating. Counsel presented no case law in support of this requirement, and the Court in aware of none.

[14] Evidence objected to in Comfort Silkie's Objections to Declarations of Pocaro [sic] and Bates, filed January 26, 1998, has not been relied upon by the Court, and the Court therefore does not determine the evidentiary objections.

(1) A pink blanket made sometime between September 23, 1987 and September 23, 1988[15] (this blanket is Defendant's Exhibit 12) (Porcaro Decl. ¶4, Porcaro Depo. 70:15-72:2);

(2) A white patterned flannel and satin blanket with a blue border, used on the Fourth of July, 1987, at Winnetka Park (a photograph of the blanket in use is Exhibit 55-E, and the photograph itself bears this date[16]) (Porcaro Depo. 53:1-54:15, 82:22-25);

(3) A blue satin blanket used in May or June, 1987, at the La Jolla Beach and Tennis Club (a photograph of this blanket in use is Exhibit 55-M) (Porcaro Depo. 55:5-13; 83:2-16);

(4) A red blanket used in May or June, 1987 in Connecticut (a photograph of this blanket in use is Exhibit 55-K) (Porcaro Depo; 56:11-57:15; 84:17-21);

(5) A white blanket used in December, 1987 at LAX (two photographs of this blanket in use are Exhibits 55-J and 5S-L) (Porcaro Depo. 58:20-25, 6S:14-66:16)[17];

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[15] The evidence does not clearly indicate whether this blanket was made and in public use on or before June 19, 1988. It has been retained on this list on the basis that this is the only Porcaro blanket actually presented as an exhibit, and relevant testimony compares the other blanket to this one. The Court's determination of the public use issue does not depend on ! this blanket.

[16] The deponent, Cheryl Porcaro, has testified that she is in the photograph. (Porcaro Depo. 54:12-15.)

[17] The deponent testified that the date was written on the 5 back of the photograph by her sister-in-law. (Porcaro Depo.

(6) A blue satin blanket used on April 19, 1987 (a photograph of this blanket in use is Exhibit 55-T) (Porcaro Depo. 61:9-62:2);

(7) A red blanket used in May, 1987 (a photograph of this blanket in use is Exhibit 55-B) (Porcaro Depo. 64:8-65:2).[18]

Seifert has presented admissible evidence that all of these blankets were constructed in the following way: "the satin border turned over, sewn on the satin making a corner, sewn down on top of the flannel," "satin, trimmed with the little border and the flannel inside." (Porcaro Depo. 46:16-47:4; 93:4-23.) Seifert has also presented admissible evidence with respect to all of these blankets that they were taken into public places "very frequently" and that no attempt was made to conceal the blankets or any aspect of their construction. (Porcaro Depo. 85:18-88:18; 93:2494:7.) As evidence in support of the dates on which these photographs were taken, Seifert has presented the testimony of Cheryl Porcaro, from whose chronologically ordered personal family photograph albums the pictures came. (Porcaro Depo. 91:13-93:3.) Seifert has presented admissible evidence that all the Porcaro blankets were between 29" x 36" and 36" x 45" in size. (Porcaro Depo. 31:8-32:4.)

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66:9-16.) She testified that she did not recall when she got the photograph, and that her recollection of the date was based on her memory of the event and the place in which the photo was located in her own photo album. (Porcaro Depo. 65:19-25.)

[18] The deponent testified that this date was written on the photograph by her sister-in-law. (Porcaro Depo. 64:19-24.)

Comfort Silkie has presented no evidence raising a genuine issue of material fact as to whether these blankets were taken into public places like airports, public park., and restaurants, with no expectation of privacy or confidentiality. This use more closely resembles that in Beachcomber, supra, than a demonstration with an expectation of privacy-and control as in Moleculon, supra. The Porcaro testimony therefore constitutes "clear and convincing" evidence that these blankets were in public use more than a year before application for patent '285.

3. Invalidity of Independent Claims

The remaining question, then, is which patent claims are thereby invalidated by the public use of the Porcaro blankets. Each of the Porcaro blankets

(1) is an apparatus "[for] providing" pacification to an infant;

(2) "by tactile simulation of an amniotic environment"

(3) made of two textile sheets of different tactile properties;

(4) connected together at their common periphery;

(5) to allow "slipping" when stroked.

The two sheets are connected

(6) only at their periphery.

On this basis, the evidence about the Porcaro blankets INVALIDATES independent Claim 1 of the '285 patent on the basis of public use, under 35 U.S.C. §102(b).

The evidence about the Porcaro blanket. shows that each is constructed of

(7) one sheet of flannel and one sheet of satin.

On this basis, independent Claim 6 of the '285 patent is INVALID on the basis of public use.

The blankets have

(10) a border around the edges of the blanket, which is

(11) a textile border.

On this basis, the Porcaro blankets invalidate independent Claim 8 and 9.

Seifert has not presented evidence that the flannel is

(8) "brushed" flannel.

However, under Monroe, supra, the flannel in the Porcaro blankets need only be "substantially the same" as the brushed flannel required by Claim 7. It is not disputed that "brushed flannel" is a variety of flannel. No admissible evidence has been offered raising a genuine issue of material fact to show that "flannel" and "brushed flannel" are not substantially the same in the context of the '285 patent. Therefore, the flannel in the Porcaro blankets must be found to be substantially the same as the brushed flannel required by Claim 7. Thus, the Porcaro blankets also INVALIDATE independent Claim 7 of the '285 patent on the basis of public use.

Seifert has not presented evidence that the satin in the Porcaro blankets is

(9) "charmeuse" satin.

Seifert has presented evidence that "charmeuse" satin differs from other sorts of satin in its "fiber content and finishing process," and may differ in "weight." (Seifert Depo. 109:4-

112:9; Supp. Seifert Decl. 8(d).)[19] However, under Monroe, supra, the satin in the Porcaro blankets need only be "substantially the same" as that required by Claim 12 in order to be an invalidating public use. It is undisputed that charmeuse satin is a variety of satin. No admissible evidence has been presented to show that the satin in the Porcaro blankets in not substantially the same as the charmeuse satin required by Claim 12. Claim 12 also includes the limitation that

(13) the "co-efficient of sliding friction [between the two sheets] is simulative of fluidic friction.

No admissible evidence has been presented pertaining to the "sliding friction" exhibited by the Porcaro blankets. However, read in the light of the patent specifications, as permitted by flank, supra, this element is satisfied so long as when the blanket is manipulated, a "smooth glide is sensed." Exhibit 12 exhibits this feature, and Seifert has presented evidence that all the Porcaro blankets were constructed in the same way as Exhibit 12. (Porcaro Depo. 46:16-47:4; 93:4-23.)

The Porcaro blankets include a satin sheet; "charmeuse satin" is a variety of satin; and there is an absence of any evidence of substantial difference between them. In addition, the Porcaro blankets exhibit a smooth glide" when manipulated. On this basis, the Porcaro blanket. also INVALIDATE

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[19] Although Seifert has testified that acetate satin a. used in the Seifert blankets "substantially differs" from polyester satin used in Comfort Silkie's blankets (Seifert Supp. Decl. ¶8(d)), this is not relevant to the question of whether the satin used in the Porcaro blankets is ``substantially the same" as the charmeuse satin required by Claim 12.

independent Claim 12 of the '285 patent on the basis of public use.

Therefore, summary judgment in favor of Seifert should be GRANTED that the public use of the Porcaro blanket. Invalidates independent Claims l, 6, 7, 8, 9 and 12 of the '285 patent under 35 U.S.C. §112.

4. Invalidity of Dependent Claims

Where an independent claim has been invalidated on the basis of public use, it is necessary next to determine whether the invention in public use also embodies all the elements of each dependent claim. Because the dependent claims add further limitations to the independent claims, under 35 U.S.C. §112, a device embodying all the elements of an independent claim, which is therefore "anticipatory" of those claims under 35 U.S.C. §102 (b), will not anticipate and thereby invalidate the dependent claims unless it also embodies all the elements of those dependent claims.

Dependent Claims 2, 3, 4, and 10 add further limitations to Claims 1 and 9, which have been invalidated on the basis of public use. Claims 2, 3, and 10 add that the two sheets have

(12) "low" sliding friction.

Claims 3 and 4 add that

(13) the "co-efficient of sliding friction [between the two sheets] simulate[s] the sliding of two flexible layers with an interlying liquid layer."

Defendant Seifert has not presented admissible evidence pertaining to the Sliding friction" exhibited by the Porcaro blankets. However, read in the light of the patent specifications, as permitted by Haney, supra, these claim elements are satisfied so long an when the blanket is ,

manipulated, a "smooth glide is sensed. Exhibit 12 exhibits this feature, and Seifert has presented evidence that all the Porcaro blankets were constructed in the same way as Exhibit 12. (Porcaro Depo. 46:16-47:4; 93:4-23.) On this basis, Seifert's motion for summary judgment of invalidity on the basis of public use as to dependent Claims 2, 3, 4 and 10 is GRANTED.

Dependent Claims 5 and 11 impose a size limitation of (14) 14" x 18" to independents Claims 1 and 9, respectively. Seifert has presented admissible evidence that all the Porcaro blankets were between 29" x 36" and 36" x 45" in size. (Porcaro Depo. 31:8-32:4.) Summary judgment of invalidity on the basis of public use as to dependent Claims 5 and 11 should therefore be DENIED.[20]

V. INFRINGEMENT ARGUMENTS

On the basis of the foregoing, summary judgment has been granted that independent Claims 1, 6' 7' 8, 9 and 12, and dependent Claims 2, 3, 4 and 10, are invalid on the basis of public use, under 35 U.S.C. §112. Therefore, the Court's a analysis of infringement is confined to a determination of whether Seifert's blankets infringe the only remaining claims, dependent Claims 5 and 11. Although the independent claims have been invalidated, in determining whether there has been infringement of the dependent claims, it is necessary to

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[20] Because the Porcaro blankets do not include all the limitations of dependent Claims 5 and 11 of the '285 patent, these dependent claims are not "anticipated" by the public use and are therefore not invalid under §102(b). However, a nonanticipatory public use more than one year before the claim's effective filing date may render the claim invalid for obviousness under 35 U.S.C. §103. Elmer V. ICC Fabricating, Inc. 67 F.3d 1571, 1574 (Fed. Cir. 1995).

ascertain whether the accused devices embody all the elements of the independent claims on which the dependent claims depend. Wahpeton Canvas Co. v. Frontier, Inc., 870 F.2d 1546, 1552 n. 9 (Fed. Cir. 1989).

There are three accused devices in this case to be compared with the remaining valid claims of the '285 patent, dependent Claims 5 and 11:

(1) a 13" x 18" "Blankie-To-Go" with a 4" x 6" center panel on the flannel side, whose corners are tacked through to the beige satin side, and whose two sides are also connected at the periphery (Pl.'s Lodged Exh. J. hereafter "beige Blankie"; Def's Facts 2, 4-7);

(2) a 27" x 36" "Dream With Me" blanket with a 9 1/2 x 10" panel and rose satin, whose sides are connected only at the periphery (Pl.'s Lodged Exhibit H.; Def.'s Facts 2, 9, 10); and

(3) a 13" x 18" "Blankie-To-Go" with a 4" x 6" panel and green satin, whose two sides are connected only at the periphery (Pl.'s Lodged Exh. G, hereafter "green Blankie"; Def.'s Facts 2, 4-6).

Seifert's motion for summary judgment makes two arguments: that the beige Blankie ((1) above) does not infringe the '285 patent because of its center panel; and that the Dream With Me blanket ((2) above) does not infringe the '285 patent because of its size.[21] Seifert's motion does not address the green Blankie.

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[21] As noted above, Seifert's motion is treated as troth a motion for summary Judgment in Seifert's favor on Comfort Silkie'. claim of patent infringement, and as ~ motion for summary judgment in Seifert's favor on Seifert's own counterclaim for declaratory judgment of noninfringement.

A. The Beige Blankie

The beige Blankie contains all the basic elements of the claims of the '285 patent set out above. The beige Blankie

(1) is an apparatus "providing" or "for providing" pacification to an infant;

(2) "by tactile simulation-of an Amniotic environment"

(3) made of two textile sheets of different tactile properties;

(4) connected together at their common periphery;

(5) to allow "slipping" when stroked.

It is made of

(7) one sheet of satin and one of flannel. It has a (10), (11) textile border.

It exhibits

(12) low sliding friction. (Troncone Deal. ¶25, 26, 29.)

Because the two sheets are not

(6) connected "only" at their periphery, as required by dependent Claim 5, summary Judgment that the beige Blankie infringes Dependent Claim 5 is DENIED under Laitram, supra.[22] Dependent Claim 11 limits Claim 9 to embodiments no larger than

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[22] At oral argument, counsel for Seifert argued, on the basis of language in the specification that teaches away from "stitching," that a blanket tacked through at four points (like the beige Blankie) could not "simulate the amniotic

(14) 14" x 18".

The beige Blankie is 13" x 18". On this basis, summery adjudication is GRANTED in favor of Comfort Silkie that the beige Blankie infringes dependent Claim 11. Seifert's motion for summary adjudication of non-infringement therefore is GRANTED as to Claim 5, and DENIED as to Claim 11.

B. The Dream With Me Blanket

The Dream With Me blanket

(1) is an apparatus "providing" or "for providing" pacification

to an infant;

(2) "by tactile simulation of an amniotic environment"

(3) made of two textile sheets of different tactile properties;

(4) connected together at their common periphery;

(5) to allow "slipping" when stroked.

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environment" and thus does not infringe any claim of the patent. The Court declines to alter the claim construction of element (2) set out at 16:18-17:24 supra. Because "tacking" at four points in the center of a blanket is neither literally nor equivalently the same as the complete absence of any stitching other than at the periphery, which is what dependent Claim 5 requires, the beige Blankie does not infringe dependent Claim 5. Because a warm and silky blanket satisfactorily simulates the amniotic environment, the beige Blankie does infringe dependent Claim 11.

The two sheets are connected

(6) only at their periphery.

(7) One sheet is satin and the other, flannel, specifically

(8) brushed flannel.

The blanket has (10), (11) a textile border around the edges of the blanket.

Comfort Silkie has presented evidence that the Dream With Me blanket contains these elements. (Troncone Deal. ¶25, 26, and 29.)

However, Claims 5 and 11 require that the blanket be (14) 14" x 18" or smaller. The Dream With Me blanket is 27" x 36". Because the Dream With Me blanket fails to include one element of Claims 5 and 11, under Laitram, supra, summary adjudication in favor of Comfort Silkie that the Dream With Me blanket infringes Claims 5 and 11 is DENIED. The Court GRANTS Seifert's motion for summary adjudication of noninfringement that the Dream With Me blanket does not infringe Claims 5 and 11 of the '285 patent.

C. The Green Blankie

The green Blankie was not included in Seifert's motion, but was addressed by Comfort Silkie's motion.[23] The green Blankie

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[23] Seifert has presented evidence that the green Blankie "was produced for only a few weeks in March 1996 and only in minimal numbers." (Seifert Declaration, January 16, 1998, 4:19-20.) This fact may bear on the amount of damages to be awarded, but does not affect the determination of

(1) is an apparatus "providing" or "for providing" pacification to an infant;

(2) "by tactile simulation of an amniotic environment"

(3) made of two textile sheets of different tactile properties;

(4) connected together at their common periphery;

(5) to allow "slipping" when stroked.

The two sheets are connected

(6) only at their periphery.

(7) One sheet is satin and the other, flannel, specifically

(8) brushed flannel.

The blanket has

(10), (11) a textile border around the edges of the blanket. Comfort Silkie has presented uncontroverted admissible evidence that the green Blankie has all these elements. (Troncone Decl.¶24, 25, 26, and 29.)

Dependent Claims 5 and 11 also require that the blanket be (14) 14" x 18" or smaller.

The green Blankie is 13" x 18". On this basis, summary adjudication in favor of Comfort Silkie is GRANTED that the green Blankie infringes Dependent Claims 5 and 11.

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infringement. Mannesmann Demag Corp. v. Engineered Metal Prods., 793 F.2d 1279 (Fed. Cir. 1986).

## VI. CONCLUSION

Seifert's motion for summary judgment of invalidity on the basis of indefiniteness is DENIED. Seifert's motion for summary judgment of invalidity on the basis of lack of enablement is DENIED.

On the basis of the clear and convincing evidence of public use by Porcaro, the Court:

(1)GRANTS Seifert's motion for summary adjudication of invalidity on the basis of public use as to Claims 1, 2, 3, 4, 6, 7, 8, 9, 10 and 12 of the '285 patent; and therefore,

(2) DENIES Comfort Silkie's motion for summary adjudication of infringement as to Claims 1, 2, 3, 4, 6, 7, 8, 9, 10 and 12.

However, because the admissible evidence does not show that the Porcaro blankets embody all the elements of two of the dependent claims of the '285 patent, the Court:

(5) DENIES Seifert's motion for summary adjudication of invalidity on the basis of public use as to Claim. 5 and 11.

On the basis of undisputed evidence about the accused devices, the Court:

(6) GRANTS Comfort Silkie's motion for spry adjudication of infringement that the beige Blankie infringe. Claim 11 of the '285 patent, and DENIES Comfort Silkier motion for summary adjudication of infringement as to whether the beige Blankie infringes Claim 5 of the '285 patent;

(7) GRANTS Seifert's motion for summary adjudication of noninfringement that the beige Blankie does not infringe Claim 5 of the '285 patent, and DENIES Seifert's motion for summary adjudication of non-infringement as to whether the beige Rankle infringes Claim 11 of the '285 patent;

(8) DENIES Comfort Silkie's motion for summary adjudication of infringement as to whether the Dream With He blanket infringes Claims 5 and 11 of the '285 patent;

(9) GRANTS Seifert's motion for summary adjudication of noninfringement that Dream With Me blanket does not infringe -. Claims 5 and 11 of the '285 patent; and

(10) GRANTS summary adjudication in favor of Comfort Silkie that the green Blankie infringes Claims 5 and 11 of the '285 patent.[24]

On this basis, Claims 1, 2, 3, 4, 6, 7, 8, 9, 10 and 12 have been INVALIDATED. Infringement has been found as to Claims 5 and 11.

This result does not preclude the defendants from bringing forward other invalidity defenses as to Claims 5 and 11, such as obviousness under 35 U.S.C. §103 or invention by another under 35 U.S.C. §102(g), which may then invalidate those claims and moot any infringement. The Motions Cut-Off, Pretrial Conference, and Trial dates in this case are VACATED AND RESET as follows:

Motions Cut-Off: May 18, 1998; Pretrial Conference: June 15, 1998; and Trial, June 22, 1998.

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[24] Seifert's own motion for summary judgment does not address the green Blankie.

APPENDIX A

(Independent Claims are indicated in bold)

| Element | 1 | 2 | 3 | 4 | 5 | 6 | 7 | 8 | 9 | 10 | 11 | 12 |
|---|---|---|---|---|---|---|---|---|---|---|---|---|
| (1) providing pacification | X | X | X | X | X | X | X | X | X | X | X | X |
| (2) tactile simulation of amniotic environment | X | X | X | X | X | X | X | X | X | X | X | X |
| (3) two different textiles | X | X | X | X | X | X | X | X | X | X | X | X |
| (4) connected at periphery | X | X | X | X | X | X | X | X | X | X | X | X |
| (5) to allow slipping | X | X | X | X | X | X | X | X | X | X | X | X |
| (6) connected ONLY at periphery | X | X | X | X | X | X | X | | | | | X |
| (7) one satin, one flannel | | | | | | X | X | X | X | X | X | X |
| (8) brushed flannel | | | | | | | | X | | | | X |
| (9) charmeuse satin | | | | | | | | | | | | X |
| (10) with a border | | | | | | | | X | X | X | X | |
| (11) with a textile border | | | | | | | | | X | X | X | |
| (12) "low" sliding friction | | X | X | | | | | | | X | X | |
| (13) coefficient of sliding friction ~ liquid | | | X | X | | | | | | | | X |
| (14) 14" x 18" in size | | | | | X | | | | | | X | |

IT is so ORDERED. Dated: March 31, 1998

Lourdes G. Baird, United State. District Judge